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Supreme Court, U. S.
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IN THE

Supreme Court of the United States

OCTOBER TERM, 1972

No.

LONG MANUFACTURING COMPANY, *Petitioner*

v.

LILLISTON IMPLEMENT COMPANY, *Respondent.*

PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FOURTH CIRCUIT

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LONG MANUFACTURING COMPANY, *Petitioner*

v.

LILLISTON IMPLEMENT COMPANY, *Respondent.*

PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FOURTH CIRCUIT

Long Manufacturing Company, petitioner, prays that a writ of certiorari issue to review the judgment of the U. S. Court of Appeals for the Fourth Circuit entered in this proceeding on April 4, 1972.

I

ORDERS, OPINIONS AND JUDGMENTS BELOW

Opinion of the Fourth Circuit Court of Appeals, dated April 4, 1972, Appeals Nos. 71-2016 and 71-2017, not officially reported, unofficially reported at 173 USPQ 321 (1a). Order concerning costs filed May 24, 1972 (2a).

Opinion of the District Court, E. D. N. C. decided June 14, 1971, corrected July 13, 1971 (Walter E. Hoffman, District Judge, presiding by Special Assignment from Eastern District of Virginia), reported at 328 F. Supp. 268 (2a).

Judgment of the District Court, E. D. N. C (8-12-71) (41a).

II

STATEMENT OF THE GROUNDS ON WHICH JURISDICTION OF THIS COURT IS INVOKED

The per curiam opinion and judgment of the Fourth Circuit Court of Appeals dated and entered April 4, 1972 is sought to be reviewed. Jurisdiction to review by writ of certiorari is believed conferred by 28 U.S.C. 1254(1).

III

QUESTIONS PRESENTED

1. Whether the Courts below have decided a Federal question in a way which conflicts with applicable decisions of this Court. In particular:

(a) Whether a novel combination of elements may properly be held unpatentable where the Court relies on *A. & P. Tea Co.* v. *Supermarket Corp.*, 340 U.S. 147 (1950) and does not apply *Graham* v. *John Deere Co.*, 383 U.S. 1 (1966).

(b) Whether, assuming the question of part (a) is answered affirmatively, the Court below erred in its application of *A & P* by its failure to make any finding as to whether Long's admittedly novel combination of elements "perform any additional or different function in the combination than they perform out of it." (340 U.S. 147 at 152).

2. Whether there is a conflict between this Court's rulings in *Anderson's-Black Rock, Inc.* v. *Pavement Salvage Co.*, 396 U.S. 57 (1969) (including *A & P*) and *Graham* which should be clarified pursuant to 35 U.S.C. 103 and the stabilizing effect which Congress intended that it have.

IV

CONSTITUTIONAL PROVISIONS, STATUTES INVOLVED

This case involves the commerce and patent clauses of the Constitution of the United States, Article I, Section 8 (42a), 28 U.S.C. 1254 (42a), 35 U.S.C. 103 (42a), 35 U.S.C. 282 (43a) and Rules of the Supreme Court, Rule 19(1)(b) (43a).

V

STATEMENT OF THE CASE

A. Proceedings of the Case

On August 26, 1967 the petitioner instituted the present action against respondent for infringement of Long patents 2,974,467 and 3,007,475, the patents in suit. Both of these patents relate to a peanut combine and stem from a single application which was directed to the overall combine. The Patent Office, however, required division on the ground that the pickup and threshing portions, or front end of the combine, should be patented separately from the cleaning, separating and collecting portions, or back end of the combine. In a written opinion the District Judge held patent '467, on the front end, invalid and not infringed, and patent '475, on the back end, invalid and infringed. Both parties appealed the adverse rulings. The Fourth Circuit Court of Appeals affirmed invalidity on the stated ground of obviousness in a per curiam opinion without discussion and without consideration of the infringement issues.

B. The Patents in Suit

The Long patents in suit disclose and claim a peanut combine upon which the peanut industry is dependent. The District Judge recognized that Long's combine supplants prior combines and includes a novel arrangement affording at least two advantages over the prior art (13a, 14a) but concluded that the combination "does not constitute an invention", citing *A & P Tea Co.* v. *Supermarket Corp.*, 340 U.S. 147 as the leading case (12a, 13a).

The patented combine (patent '467 description at 6a) includes (1) a rotary pickup for lifting previously plowed peanut vines from the ground; and (2) a series of threshing cylinders which receive the vines from the pickup and are arranged on an incline so that they simultaneously (a) *elevate* the vines and (b) *thresh* the vines. The vines and peanuts are then located at the required elevation for further processing in the combine.

The prior art combines did not have the threshing cylinders arranged on an incline effective to elevate. Instead, the prior art employed an *additional* element, a lengthy inclined conveyor between the pickup and threshing cylinder(s), to perform the elevating function (11a, 12a). Thus the prior art combine included (1) a rotary pickup; (2) a lengthy inclined conveyor; and (3) one or more threshing cylinders positioned at the required threshing elevation.

The patented combine eliminates the lengthy inclined conveyor (13a) by arranging the threshing cylinders on an incline to perform the dual function of elevating and threshing.

The District Court's opinion states: "The only possible evidence of a new combination in patent 2,974,467

is the method whereby the peanut vines are fed directly from the rotary pickup to the first threshing cylinder" (11a).

Further,

> "In fact the only thing that is at all different in the front end of Long's combine is the arrangement whereby the conveyor is eliminated and the first threshing cylinder is lowered. Even recognizing, as the plaintiff suggests, that the advantages of such an order are to reduce the overall height of the combine and prevent the vines from getting clogged at the point of transfer to the first threshing cylinder, it cannot be concluded that this arrangement produces a new result either as related to the entire combine or the working of the individual parts." (13a, 14a).

The combines of the prior art were discontinued when Long's invention became known. The District Court stated:

> "* * * we take cognizance of the fact that some of the combines considered here as part of the prior art had been discontinued around the time that Long received his patent. * * * (37a).
>
> * * *
>
> "We are also mindful of the fact that while many peanut combines previous to Long's were not commercially feasible, Long's machine has enjoyed substantial commercial success. * * *" (38a).

The conceded novelty and advantages of Long's combine should be considered in the context of the importance of such combines. Without belaboring this petition with references to the transcript of trial, we merely refer to the District Court's findings, including

the reduction of hazard of rain damage to the exposed (plowed up) peanut crop (5a).

The second patent, 3,007,475, on the back end of the combine, is directed to a combination of elements which was described in part by the District Judge as follows:

> "The back end or the cleaning, separating, and collecting portions of the combine are embodied in patent number 3,007,475. More specifically, this patent involves a stepped pan which receives peanuts falling through the openings in the second arcuate breastplate (under the rear threshing cylinder). Peanuts are also received on this pan as they drop from the vines as the vines move downwardly along the vine rack on their way to being discharged through the exhaust. At the rearward end of the stepped pan is a declining stepped screen, which at its rearward end has a series of tines. The peanuts, which move toward the rear of the machine by an oscillating type motion, undergo their initial cleaning due to the jiggling effect on the peanuts as they are spread over and pass rearwardly on the surface of the pan. As the peanuts pass off the end of the stepped pan and onto the declining stepped screen, they enter a second cleaning phase whereby, due to air from the first blower passing through the steps and the jiggling motion of the combine causing the peanuts to bounce from one step to the next, clods of dirt and other foreign matter are separated from the peanuts. The stepped screen has holes in it through which an object the size of a peanut will fall and move to the collecting point without passing over the tines at the end of the stepped screen or the stemmer saws underneath. Most of the peanuts, however, will be carried down the stepped screen, through the tines, and into the stemmer saws. These little saws will then, as they rotate and cut the vine stems, carry the peanuts to the collecting point. * * *" (24a)

With reference to the above, the Judge stated:

> "Of the three aforementioned elements which the plaintiff contends makes his machine different from the prior art, Long mainly relies on what he calls a 'downwardly inclined stepped screen.' Although it is true that the plaintiff has the first machine with a stepped screen inclined toward the rear, it has already been shown that this is not the first combine to contain a stepped screen; nor is it the first combine where the screen works in connection with a blower in the cleaning process, which Long alleges is one of the advantages of his particular arrangement. Furthermore, this is not the first combine which has suggested a slanting screen. * * *" (31a)

The District Court held both patents invalid on the ground that each *element* of each was *obvious* and that the claimed combination of each did not constitute invention. Thus, with reference to patent '467 the District Judge stated:

> "This examination of the prior art as compared with each element of the patent in question compels the conclusion that each element was obvious to one of ordinary skill in the art, and therefore would not be patentable separately. * * * (11a)
>
> * * *
>
> "The leading case on the question of whether the combination of old elements into a new device constitutes an invention is *Great Atlantic & Pacific Tea Co.* v. *Supermarket Equipment Co.*, 340 U.S. 147 * * * (12a)
>
> * * *
>
> "An analysis of the facts of our case in light of the law of *A & P* as applied to the facts of that case leads us to conclude that the combination of old elements in Long's patent number 2,974,467

does not constitute an invention and therefore the Court finds the patent invalid under 35 U.S.C., section 103. * * *" (13a)

With reference to patent '475

"* * * An in-depth comparison of the prior art, with what Long claims, will reveal the lack of novelty and nonobviousness and hence the lack of invention of any single element. (29a)

* * *

"From the foregoing survey of the prior art as compared with each element in the patent, it is clear that each feature of the patent was obvious to one skilled in the art and therefore would not be patentable by itself. It is equally clear, however, that if invention can be found in the combination of these old elements, then the patent is valid. * * * (Citing *Anderson's* and *Webster Loom Co.* v. *Higgins,* 105 U.S. 580, 1881) (30a)

* * *

"* * * Under the authority of *A & P* and other cases heretofore cited, we cannot agree with the plaintiff, but rather hold that the arrangement of parts here was only one of mechanical skill and cannot be marked with the stamp of invention." (31a)

In its Summary and Conclusions the District Court made no mention of *Graham* or the obviousness test. It said:

"* * * Hence, even with the positive aspects of Long's machine taken into consideration, we must find that each patent only evidences mechanical skill, but is not inventive and therefore not patentable. * * *" (39a)

REASONS FOR GRANTING THE WRIT

The reasons for granting the writ are:

1. The question of patentability was purportedly decided in reliance upon *A & P Tea Co.* v. *Supermarket Corp.*, 340 U.S. 147 (1950). *Graham* v. *John Deere Co.*, 383 U.S. 1 (1966) was *not* applied. Therefore, the courts below decided a Federal question in a way which conflicts with applicable decisions * of this Court.

2. Assuming the viability of *A & P*, without reference to *Graham*, the District Court below erred in its application of *A & P* and was not corrected by the Circuit Court.

3. There is a basic conflict between *Anderson's* (including *A & P*) and *Graham* which a proper develop- of the law requires be resolved.

1

With reference to the first ground, it is clear that the District Judge decided the issue of patentability in a way that conflicts with applicable decisions of this Court. It found the *individual* elements to be *obvious*, indicating a basic misunderstanding of Section 103 and *Graham*, ("the subject matter as a whole" or combination must not have been obvious), but then held under *A & P* that the combination did not constitute an "invention". No finding purports to apply the true criteria of *Graham*. Thus, there was no attempt to resolve the level of ordinary skill in the pertinent art, despite the District Court's finding that Long's patented combine supplanted prior combines.

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* Two companion cases, *Colgate-Palmolive Co.* v. *Cook Chem. Co.*, 383 US 1 (1966) and *United States* v. *Adams*, 383 US 39 (1966) were decided simultaneously.

Nor did the District Court make a direct determination of obviousness or nonobviousness of the *combination* nor give any weight to secondary considerations as set forth in *Graham*.

In short, the District Court purported to apply *A & P* and did not apply *Graham*.

The opinion of the Circuit Court states that it agrees with the District Court's decision on the ground of *obviousness*. To the extent that the District Court's decision is based on *obviousness* it is clearly erroneous, as pointed out above, and hence so is the affirmance.

The application of the obviousness test by the Courts below is, therefore, clear error. The reliance on *A & P*, instead of on *Graham*, unless the "invention" criteria of *A & P* has been revived by *Anderson's-Black Rock, Inc.* v. *Pavement Salvage Co.*, 396 U.S. 57 (1969), is also clear error and reason for granting this writ.

2

Assuming the viability of *A & P* without *Graham*, the District Court erred in its application of this case. In *A & P* this Court stated as guiding principles:

> "Neither Court below has made any finding that old elements which made up this device perform any additional or different function in the combination than they perform out of it. * * *"

Further, the Court stated:

> "* * * A patent for a combination which only unites old elements with no change in their respective functions, such as is presented here, obviously withdraws what already is known into the field of its monopoly and diminishes the resources available to skillful men. * * *"

In its findings and conclusions the District Court stated that Long's combine was novel in "the arrangement whereby the conveyor is eliminated and the first threshing cylinder is lowered" (13a).

The Court then concluded:

> "Even recognizing, as the plaintiff suggests, that the advantages of such an order are to reduce the overall height of the combine and prevent the vines from getting clogged at the point of transfer to the first threshing cylinder, it cannot be concluded that this arrangement produces a new result either as related to the entire combine or to the working of the individual parts. * * *" (13a, 14a)

Thus, in the case at bar there was no finding whether the elements perform any additional or different *function* in the combination than they perform out of it. It is inherently certain that they do since their conjunction performs all of the necessary functions of prior art combines even though the prior art conveyor has been eliminated. Furthermore, the advantages, including preventing the vines from getting clogged, are indicative of a new or different function. On its face this meets the tests set forth in *A & P,* as well as in *Anderson's.* Both of these refer to a "new or different function". Thus, the decision below purporting to be based on *A & P* cannot be supported since no consideration was given to whether a "new or different function" is produced. While the Judge stated that "it cannot be concluded that this arrangement produces a new result * * *", (14a), this conclusion cannot be valid without considering whether the elements produce a "new or different function" under either *A & P* or *Anderson's.*

3

A further reason for allowance of the writ is the necessity for resolving the conflict that has resulted from this Court's decisions in *Graham* and *Anderson's*. This has direct application to this case because the District Judge relied on the "invention" test of *A & P* which may have been revived in *Anderson's,* despite giving lip service to *Graham.* No explanation is given in the Circuit Court's per curiam opinion for its purported affirmance of the holding of obviousness.

The District Court's reasoning is a return to that which was frequently applied prior to *Graham* in which this Court observed that *invention* "cannot be defined in such manner as to afford any substantial aid in determining whether a particular device involves an exercise of the inventive faculty or not" (383 U.S. at 11, 12). A primary purpose of this Court's instructive decision in *Graham* apparently was to present a functional or objective approach to a determination of patentability in place of the "less definite 'invention' language of *Hotchkiss** that Congress thought had led to 'a large variety' of expressions in decisions and writings" (383 U.S. at 14).

Apparently due to *Anderson's,* however, *Graham* has been shoved aside although given lip service as indicated by the holdings below.

Since this Court's reversal of the Fourth Circuit Court of Appeals in *Anderson's* in December 1969, no patent has been upheld by that Court. Furthermore, except for three cases in which it reversed lower court decisions upholding patents, that Court has merely af-

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* *Hotchkiss* v. *Greenwood,* 11 How. 248 (1851).

firmed *per curiam* without explanation all of the eight decisions against patents which it has received on appeal (47a).

In the five years prior to *Graham* (1961-1965, inclusive) the Fourth Circuit Court of Appeals ruled in favor of patents in seven cases. It reversed to rule against patents in six. It affirmed decisions below against patents in nine, but in five of these it wrote substantial opinions with reasons, affirming per curiam without reasons in only four (44a, 45a).

In the period between Graham (February, 1966) and *Anderson's* that Court upheld two patents, reversed favorable holdings in three, wrote affirming opinions with reasons against patents in four, and affirmed per curiam without reasons in five (46a).

Thus, its attitude since *Anderson's* has rigidified to the point where there is no effective appellate review of a decision against a patentee in the area covered by the Fourth Circuit Court of Appeals. That this condition will continue until this Court speaks again appears virtually certain. That this condition exists, in view of the mandates of the Constitution, Article I, Section 8, and of the Statutory presumption of validity, 35 U.S.C. 282, indicates the need for clarification by this Court at this time.

The confusion that has resulted from this Court's decision in *Anderson's* has been manifested in many petitions for certiorari, in decisions of the lower courts, and by commentators.

Decisions in other Circuits subsequent to *Anderson's* indicate shelving of *Graham*. See, for example, *Exer-Genie Inc.* v. *McDonald,* 453 F. 2d 132 (9 Cir. 1971), cert. den. April 17, 1971, No. 71-1042, in which the Cir-

cuit Court relied on *A & P* and *Cuno Corp.* v. *Automatic Devices Corp.*, 314 U.S. 84 (1941). The overriding impact of *A & P* and *Anderson's* is indicated in *Blair* v. *Dowds Inc. et al.*, 438 F. 2d 136 (D.C. Cir., 1970), although reference is there made to *Graham*.

In *Hubner* v. *Sunbeam Corp.*, 320 F. Supp. 298 (SDNY 1970), affirmed per curiam, 450 F. 2d 878 (2 Cir. 1971), the Court referred to the *Graham* criteria, made the initial step of determining the level of ordinary skill in the art, but then applied *A & P* and *Anderson's*. In the *1971 Patent Law Annual of the Southwestern Legal Foundation*, the article "Recent Developments in Patent Law" by D. Carl Richards at page 262 comments on this case:

> "Such a holding is reasonably to be expected after the *Anderson's-Black Rock* decision. It is contended by some that the two tests are antithetical and that Section 103 and *Graham* effectively overruled the earlier *A & P* standard. In any case, they are *different* tests and are not easily reconcilable; consequently, one must be subordinated to the other in a given case. In *Black Rock* and again in *Hubner*, the *Graham* test appears to have taken a back seat to the older, more subjective *A & P* standard."

The article "After Black Rock: The New Tests of Patentability—The Old Tests of Invention", 39 *Geo. Wash. L. Rev.* 123, 139 et seq. (1970) begins:

> "In *Anderson's-Black Rock Inc.* v. *Pavement Salvage Co.* the Supreme Court revived the illusory 'invention' standard as a requisite of patent validity. * * * "

That *Anderson's* has resulted in a divergence among the Circuits is stated by authorities including Pro-

fessor Kayton of George Washington University, in "The Crisis of Law in Patents" (Patent Resources Group, Inc., Washington, D. C. 1970).

Professor James B. Gambrell, New York University School of Law stated:

> "It seems to me that non-obviousness—what the skilled man in the art does—is in bad disarray among the Circuits. I don't think it is any secret that most of the Circuits are not uniform either within the Circuits or between the Circuits; * * *
>
> * * *
>
> "* * * although the Court did not deal with the problem specifically and indeed it did not have to since it remanded for further evaluation by the trial court in the *Blonde-Tongue* case, the point we were trying to make is that it is an impossibility to deal with 103 in terms of looking at what the invention is, what the priority is, what the level of skill in the art is, and so on, and at the same time apply some synergistic, magical term as *Anderson's-Black Rock* and some of its predecessor cases, *Lincoln Engineering*[*] and some others, have suggested is necessary." (American Bar Association, Section of Patent, Trademark and Copyright Law, *1971 Summary of Proceedings,* pp. 161, 162)

The difficulty in *Anderson's* is that the requirement of the "new or different function" producing a "synergistic result" and the requirement for "invention" are both essentially subjective standards whose determination is elusive. Thus in *A & P,* even though the frame and store counter cooperated, the Court relied on *Lincoln Engineering Co., supra,* to state that

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* *Lincoln Engineering Co.* v. *Stewart-Warner Corp.,* 303 US 545 (1938).

the parts produce "no new or different function" and that "only when the whole in some way exceeds the sum of its parts is the accumulation of old devices patentable."

The question of a "synergistic result" (*Anderson's*) or "unusual or surprising consequences from the unification of the elements" (*A & P*) is on its face a subjective evaluation. However, both *Graham* and *Adams* instruct that objective standards are required by the Statute. The subjective tests should not rest in the law unless there is nothing better. Section 103 as interpreted by *Graham* presents better criteria and is equal to the task without being overridden by the primarily subjective and negatively biased test set forth in *Anderson's*.

A & P and *Anderson's* stand for the "improbability of finding invention in an assembly of old elements" (*A & P*, 340 U.S. at 152), despite the fact that "substantially every invention * * * consists of former elements in a new assemblage" (*Reiner* v. *I. Leon Co., Inc.*, 285 F. 2d 501, 503 (2 Cir., 1960, Hand, J.). There is no logical reason to *approach* all combinations of elements as probably unpatentable. Why should the law, which zealously protects our personal rights, including the right to use our intellects, be *biased* against our intellectual property rights? Both are keystones of this country's greatness.

In *Blonder-Tongue Inc.* v. *University of Illinois Foundation*, 402 U.S. 313 (May 3, 1971), this Court declined to consider the issue of patentability. However, Mr. Justice White's opinion referring to this issue states:

> "* * * For example, if the issue is nonobviousness, appropriate inquiries would be whether the

first validity determination purported to employ the standards announced in *Graham* v. *John Deere Co.*, * * * "

On the other hand, in *Deepsouth Packing Co., Inc.* v. *The Laitram Corp.*, No. 71-315, (May 30, 1972), although the issue of patent validity was not before the Court, Mr. Justice White's opinion observed:

"* * * Invention was recognized because Laitram's assignors [3] combined ordinary elements in an extraordinary way—a novel union of old means was designed to achieve new ends.[4] Thus, for both inventions 'the whole in some way exceed [ed] the sum of its parts.' *Great A & P Tea Co.* v. *Supermarket Equipment Corp.*, 340 U.S. 147, 152 (1950)." (Footnotes omitted in printing)

VI

CONCLUSION

Petitioner respectfully requests that this petition for a writ of certiorari be granted.

Respectfully submitted,

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APPENDIX

APPENDIX

APPENDIX A

UNITED STATES COURT OF APPEALS
FOR THE FOURTH CIRCUIT

No. 71-2016

LONG MANUFACTURING COMPANY, *Appellant,*

versus

LILLISTON IMPLEMENT COMPANY, *Appellee.*

No. 71-2017

LONG MANUFACTURING COMPANY, *Appellee,*

versus

LILLISTON IMPLEMENT COMPANY, *Appellant.*

Appeals from the United States District Court for the Eastern District of North Carolina, at Raleigh.
Walter E. Hoffman, District Judge.

Argued March 8, 1972. Decided April 4, 1972.

Before Haynsworth, Chief Judge, and Winter and Russell, Circuit Judges.

Opinion

Per Curiam:

After full consideration of the briefs and oral argument, we find ourselves in agreement with the decision of the District Court that both of the appellant's patents are invalid on the ground of obviousness to persons reasonably skilled in the art. *Long Manufacturing Co.* v. *Lilliston Implement Co.*, E.D.N.C., 328 F.Supp. 268.

We decline to award the attorneys fees sought by the appellee since this is not one of the "exceptional cases" to which this form of relief in patent cases is limited.

Affirmed.

APPENDIX B

(Filed May 24, 1972)

Order

Upon consideration of the bills of costs, motions, and responses submitted by the parties through counsel,

It is ORDERED that:

(1) the bills of costs are filed;

(2) each party shall bear its own costs.

SAMUEL W. PHILLIPS
Clerk

APPENDIX C

Memorandum Opinion of the District Court

(Filed 6/17/71)

The plaintiff, Long Manufacturing Company, a corporation of the State of North Carolina, having its principal offices in Tarboro, North Carolina, has brought this action against the defendant, Lilliston Implement Company (now by change of name Lilliston Corporation), a corporation of the State of Georgia, having its principal offices in Albany, Georgia, and a place of business at Weldon, North Carolina, located within the Eastern District of North Carolina. The plaintiff alleges that the defendant has infringed claims one through four of patent number 2,974,467, issued March 14, 1961, to W. R. Long, and all eight claims of patent number 3,007,475, issued November 7, 1961, to W. R. Long. In defense to these allegations, the defendant asserts that (1) all the claims involved are invalid because of lack of invention over the prior art; (2) all the claims involved are invalid by reason of being

vague, indefinite and incomplete; (3) defective oaths render patent number 2,974,467 null and void and therefore patent number 3,007,475 is invalid because of public use; (4) the claims of patent number 3,007,475 are invalid because in the specifications and drawings of that patent the inventor did not disclose the best mode contemplated by him in carrying out the alleged invention; and (5) even assuming the validity of the patents in question, there has not been any infringement because of material structural differences and in light of the doctrine of file wrapper estoppel.

Both of the patents in question relate to a peanut combine and stem from a single application which was directed to the overall combine. The Patent Office, however, required division on the ground that the pickup and threshing portions, or front end of the combine, should be separately patented from the cleaning, separating, and collecting portions or back end of the combine. The initial application filed June 12, 1958, finally matured into patent number 2,974,467 and was entitled, "Pickup and Threshing Unit for Peanut Combine."[1]

The second application was filed March 2, 1960. This application subsequently became patent number 3,007,475 and was entitled, "Peanut Combine."[2] Both patents were duly assigned by W. R. Long to the plaintiff, Long Manufacturing Company.[3]

History of Development of the Peanut Combine

Peanuts, which grow underground attached to vines extending above the ground, are harvested by being plowed

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[1] Plaintiff's exhibit No. 1.

[2] Plaintiff's exhibit No. 2.

[3] Plaintiff's exhibit No. 12. See also plaintiff's exhibit No. 1 and defendant's exhibit No. 18 (front page and page 74).

up and subsequently removed from the vines. Prior to the combine, the plowed-up vines with the peanuts attached were stacked around poles for a period of two to six weeks to permit drying of the vines and peanuts before picking. The stacking, which kept most of the peanuts off the ground and thereby prevented rotting in the rainy weather, was done by hand, as was the tedious task of picking.

At least as early as 1913, machines were employed to pick the peanuts from the vines and remove the stems from the peanuts.[4] The earliest peanut pickers were operated while in a stationary position, either working around the poles or by having the stacks of vines brought to the machine. These machines, which operated in a stationary position, were generally of two types: (1) the carding-type machine whereby the peanut vines would be placed on a long chain conveyor which would draw the vines through a series of fixed spring fingers which, in turn, would comb the peanuts from the vines;[5] and (2) the cylinder-type machine whereby the peanut vines placed in the machine would be drawn through the machine by the fingers, which were attached to the outer rim of the cylinders, drawing the vines along as the cylinders rotated. At the same time spring fingers extending upwardly from arcuate breastplates beneath each cylinder would comb the peanuts from the vines as the vines passed between the breastplate and cylinders.[6]

Although the stationary pickers substantially reduced the labor involved in the harvesting process, they still

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[4] Patent number 1,081,593 issued to H. W. Eisenhart and M. W. Darden (defendant's exhibit No. 53).

[5] Examples of this type machine are the Eisenhart, et al patent (defendant's exhibit No. 53); Morris patent (defendant's exhibit No. 59); and the old Lilliston patent (defendant's exhibit No. 56).

[6] Examples of this type of machine are the Livermon patent (defendant's exhibit No. 52); the Ronning patent (defendant's exhibit No. 54); and the two Good patents (defendant's exhibits Nos. 50 and 51).

required about twelve men for operation. Around 1945, the idea developed that labor could further be reduced by producing a combine which would move through the fields and harvest the peanut vines, which would previously be plowed up and placed in windrows, rather than operating the machines in a stationary position. In addition to saving labor, another attractive feature about this method of harvesting is that the peanut vines could be harvested only a short period of time after having been dug up, since they would dry more quickly in the windrows than while piled up around stakes. Accordingly, the hazard of rain damage to the exposed peanuts would be reduced. Pursuant to these ideas and advantages, many machines were developed and patented, among which are the combines involved in this litigation.

W. R. Long, the president of the plaintiff company started working on the patented combine in 1956 and, by 1957, had built his first prototype. Like the Lilliston machine which was developed around 1964, Long's combine is designed to pick up the vines and through a process of threshing cylinders and cleaning and separating devices to efficiently harvest the peanuts.

Burden of Proof

At the outset, we note that, under 35 U.S.C., section 282, a presumption of validity attaches to a patent when it is granted by the Patent Office.[7] This apparently stems from the expertise credited to patent examiners in these matters. It is clear, however, that this presumption is not conclusive. It may be rebutted by clear and convincing evidence[8]

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[7] Keiser v. High Point Hardware Co., 311 F. (2d) 850 (4 Cir., 1962); Colgate-Palmolive Co. v. Carter Products, Inc., 230 F. (2d) 855 (4 Cir., 1956), cert. denied, 352 U.S. 843 (1956), rehearing denied, 352 U.S. 913 (1956).

[8] Neff Instr. Corp. v. Cohu Electronics, Inc., 298 F. (2d) 82 (9 Cir., 1961).

and may be overcome when pertinent prior art was not before the Patent Office during its consideration of the application.[9] This is important to note at this point because, as will be shown in the text of this opinion, the defendant heavily relies on several combines[10] as references for invalidating the plaintiff's patents (particularly the Frick machine) which were not cited and apparently were not before the Patent Office during the application process.

PATENT NUMBER 2,974,467

As previously noted, patent number 2,974,467 relates to the front end or the pickup and threshing part of the peanut combine. More specifically, it involves a rotary pickup which, rotating in a clockwise direction, picks up the vines of peanuts after they have been plowed up and gathered in windrows in the field and are sufficiently dry for harvesting. The vines which are picked up by the reel are then put into contact with a large threshing cylinder with spring fingers which is rotating in a counterclockwise direction, thereby carrying the vines higher and to the rear of the combine to a transfer cylinder. The transfer (or stripper cylinder), also with spring fingers, rotates in a counterclockwise direction and carries the vines higher and to the rear to another threshing cylinder. The second threshing cylinder also has spring fingers and also rotates in a counterclockwise direction carrying the vines, which are by this time stripped of peanuts, toward the rear of the combine and out the exhaust. Underneath each of the two threshing cylinders are arcuate perforated

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[9] A R Inc. v. Electro-Voice, Inc., 311 F. (2d) 508 (7 Cir., 1962); Jaybee Mfg. Corp. v. Ajax Mfg. Corp., 287 F. (2d) 228 (9 Cir., 1961); Gillette Safety Razor Co. v. Cliff Weil Cigar Co., 107 F. (2d) 105 (4 Cir., 1939).

[10] These include the Frick combine (defendant's exhibit No. 49 and exhibit No. 82); the Livermon combine (defendant's exhibit No. 108); Case combine (defendant's exhibit No. 21 and No. 36); and the Boesch patent (defendant's exhibit No. 60).

breastplates with fingers extending upward which, coacting with the fingers of threshing cylinder and the rotating motion, perform the threshing function. The only difference between the two arcuate perforated breastplates is that only the second one (the breastplate under the smaller of the two threshing cylinders) has holes large enough to permit peanuts to fall through to a pan below. Underneath the transfer cylinder is a flat imperforate plate which connects the two aforementioned arcuate perforated breastplates.

The plaintiff alleges that of the five claims in the patent, claims one through four have been infringed. These claims are as follows:[11]

> "1. In a peanut combine relatively large threshing cylinder means having spring fingers for engaging the peanut vines, a pickup slightly ahead of and below said threshing cylinder means, said pickup being located near the earth and having fingers for engaging the peanut vines and for conveying them into contact with said threshing cylinder means, a breastplate located rearwardly of said pickup and beneath and in operative relation to said threshing cylinder means, said breastplate having openings therein and a series of spring fingers extending through said openings upwardly into the path of movement of the vines and operating in conjunction with the spring fingers on said threshing cylinder means for detaching the peanuts from the vines, the size elevation and relational arrangement of the pickup and the threshing cylinder means permitting the combine to be made of relatively low overall height.
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> "2. The structure of claim 1 in which said threshing cylinder means comprises spaced multiple threshing

[11] See plaintiff's exhibit No. 1 and defendant's exhibit No. 72 and No. 73.

cylinders one rearwardly and slightly higher than the other.

"3. The structure of claim 1 in which said threshing cylinder means comprises spaced threshing cylinders and said breastplate includes perforated arcuate portions one beneath each of said threshing cylinders with an imperforate portion therebetween and with the openings beneath the rearmost threshing cylinder being of a size to permit the peanuts to fall therethrough.

"4. The structure of claim 1 in which said pickup is of the reel type and with spring fingers for engaging the peanut vines."

An analysis of the above claims reveals that the most significant features of the front end of the combine are: (1) a reel type of pickup located near the earth which has fingers for engaging the peanut vines; (2) a large threshing cylinder which has spring fingers for engaging the vines; (3) a second threshing cylinder located rearwardly and slightly higher than the first cylinder; (4) arcuate perforated breastplate beneath each cylinder with spring fingers extending upwardly which, operating in conjunction with the spring fingers of the cylinders, detach the peanuts from the vines; and (5) the openings in the rearmost perforated arcuate breastplates being large enough to permit peanuts to fall through to the stepped pan below. With these particular features in mind, the first question we must resolve is whether those features individually or as a combination are anticipated by the prior art so as to render the patent invalid in light of 35 U.S.C., section 103.

PRIOR ART

Title 35 U.S.C., section 103, states:

"A patent may not be obtained through the invention is not identically disclosed or described as set forth

> in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made."

The recent case of *Graham* v. *John Deere Co.*, 383 U.S. 1 (1966) established the test to be applied for cases arising under 35 U.S.C., section 103.[12] In *Graham*, Mr. Justice Clark said:

> "Under § 103, the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved. Against this background, the obviousness or nonobviousness of the subject matter is determined." [13]

Applying the *Graham* test to the case at hand, it is clear that all the working parts of the outstanding features of Patent Number 2,974,467 appear in previous patents and combines, which must be considered part of the prior art.[14] The reel type of pickup which is located near the ground and which has fingers for engaging the peanut vines is

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[12] In a long and complete discussion of the requirements of patentability, the Supreme Court noted that, in addition to the long-recognized requirement of novelty and utility, Congress, in enacting section 103 in 1952, added a third statutory test of nonobviousness which must be met to establish a valid patent. Graham v. John Deere Co., 383 U.S. 1, 3 (1966).

[13] Graham v. John Deere Co., 383 U.S. 1, 17 (1966).

[14] 2 Deller's, Walker on Patents, section 107, page 114 (1964).

clearly shown in the Frick,[15] Krause,[16] Livermon,[17] Case,[18] and McElhoe[19] combines. A threshing cylinder located upwardly and rearwardly from the pickup appears in the Frick, Krause, Livermon, Ronning,[20] Landrum,[21] and two Good[22] combines. In the Frick and Good combines, and possibly even the Livermon and Ronning patents, the first threshing cylinder is "relatively large."[23] In virtually all of the above-cited prior art combines, the cylinders have spring fingers; there are arcuate perforated breastplates beneath each cylinder; spring fingers extend upwardly from each breastplate and coact with the fingers on the cylinders to thresh the peanuts from the vines as they pass between the cylinders and the breastplates; and the breastplates or portions thereof which are above the pan, which receives the threshed peanuts, have holes large enough for a peanut to pass therethrough. Like the Long combine, the Livermon patent has a series of two cylinders

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[15] Defendant's exhibits No. 49 and No. 82.

[16] Defendant's exhibit No. 55. It should be noted that this is a combine used primarily for harvesting grain. This was, however, one of the patents cited by the Patent Office in granting Long's patent (see plaintiff's exhibit No. 1), and therefore may be considered significant for its revealing structure of combines in general.

[17] Defendant's exhibit No. 108.

[18] Defendant's exhibit No. 30.

[19] Defendant's exhibit No. 124.

[20] Defendant's exhibit No. 54. Like Krause, this is primarily a grain combine and was also cited by the Patent Office in granting Long's patent (see plaintiff's exhibit No. 1).

[21] Defendant's exhibit No. 118.

[22] Defendant's exhibits No. 50, 51 and 89.

[23] At this point, the term "relatively" is used to show the relation of this cylinder to both the entire combine and the other cylinders. This term will be discussed at greater length later in the opinion in the context of whether the plaintiff, by its use, has clearly defined his claim.

whereby the rearward one is a little higher than the first. It should also be noted that the configuration of the two cylinders with a transfer cylinder between found in the Livermon patent, along with arcuate and perforated breastplates under each of the threshing cylinders and an imperforate plate which attaches the two arcuate perforated breastplates, is almost identical to the pattern used by Long.[24]

This examination of the prior art as compared with each element of the patent in question compels the conclusion that each element was obvious to one of ordinary skill in the art, and therefore would not be patentable separately. Even so, a combination of these old elements could be patentable if invention can be found in the combination.[25] The only possible evidence of a new combination in patent number 2,974,467 is the method whereby the peanut vines are fed directly from the rotary pickup to the first threshing cylinder. All previous combines that have employed a rotary type pickup have had either a conveyor or auger feeder of some type between the rotary pickup and the first threshing cylinder. In essence, therefore, the question is whether the fact that Long has eliminated the conveyor and brought the first threshing cylinder to a lower height in the machine so that the vines picked up by the

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[24] Compare defendant's exhibit No. 52 (figure 2) (also seen in defendant's exhibit No. 88) with plaintiff's exhibit No. 1 (figure 1) (also seen in plaintiff's exhibit No. 2-A).

[25] Anderson's-Black Rock, Inc. v. Pavement Salvage Co., Inc., 396 U.S. 57 (1969); Webster Loom Co. v. Higgins, 105 U.S. 580 (1881); Heyl & Patterson, Inc. v. McDowell Co., Inc., 317 F. (2d) 719 (4 Cir., 1963); Black & Decker Mfg. Co. v. Baltimore Truck Tire Service Corp., 40 F. (2d) 910 (4 Cir., 1930).

It is significant to note that even the plaintiff's expert, Nolan, testified that all of the elements, with the possible exception of a finger-type pickup, were old in the art of peanut combines. Nolan's primary contention, however, was that it was a new combination of these elements which made the patent valid. (T.R. pp. 284-286)

rotary pickup are directly conveyed to the threshing cylinder is an invention so as to validate the patent.

The leading case on the question of whether the combination of old elements into a new device constitutes an invention is *Great Atlantic & Pacific Tea Co.* v. *Supermarket Equipment Co.*, 340 U.S. 147 (1950). In that case the patentee asserted invention of a cashier's counter equipped with a three-sided frame which would move the groceries placed on the counter. In discussing the test of inventiveness from old elements combined, Mr. Justice Jackson said (p. 152):

> "The conjunction or concert of known elements must contribute something; only when the whole in some way exceeds the sum of its parts is the accumulation of old devices patentable. Elements may, of course, especially in chemistry or electronics, take on some new quality or function from being brought into concert, but this is not a usual result of uniting elements old in mechanics."

In holding that the counter in question did not constitute an invention, the Court noted:

> "This counter does what a store counter always has done—it supports merchandise at a convenient height while the customer makes his purchases and the merchant his sales. The three-sided rack will draw or push goods put within it from one place to another—just what any such rack would do on any smooth surface—and the guide rails keep it from falling or sliding off from the counter, as guide rails have ever done. Two and two have been added together and they still make only four."

The Court then added its advice to other courts faced with the same problem, where it said (pp. 152-153):

> "Courts should scrutinize combination patent claims with a care proportioned to the difficulty and im-

probability of finding invention in an assembly of old elements. The function of a patent is to add to the sum of useful knowledge. Patents cannot be sustained when, on the contrary, their effect is to subtract from former resources freely available to skilled artisans. A patent for a combination which only unites old elements with no change in their respective functions, such as is presented here, obviously withdraws what already is known into the field of its monopoly and diminishes the resources available to skillful men."

An analysis of the facts of our case in light of the law of *A & P* as applied to the facts of that case leads us to conclude that the combination of old elements in Long's patent number 2,974,467 does not constitute an invention, and therefore the Court finds the patent invalid under 35 U.S.C., section 103. As previously noted, every essential feature of patent number 2,974,467 is included at least once in the prior art, and some virtually span all the knowledge gathered on peanut combines over the first half of the twentieth century. In addition, the functions of the elements in Long's combine are the same as the functions they have performed in other combines. The reel type pickup conveys the vines initially into the machine as the reel type pickup does in Frick, Krause, Livermon and Case. The large threshing cylinder, arcuate and perforated breastplates, spring fingers extending from both the cylinders and breastplates, and the openings in the breastplates large enough to permit peanuts to fall through to a pan below, all do the same things in the same way that almost every cylinder type combine known before has done. In fact, the only thing that is at all different in the front end of Long's combine is the arrangement whereby the conveyor is eliminated and the first threshing cylinder is lowered. Even recognizing, as the plaintiff suggests, that the advantages of such an order are to reduce the overall height of the combine

and prevent the vines from getting clogged at the point of transfer to the first threshing cylinder,[26] it cannot be concluded that this arrangement produces a new result either as related to the entire combine or to the working of the individual parts. While the patentee should be commended for his success in arranging these old elements into a mechanically functional and most desirable combine, the new arrangement is only evidence of mechanical skill and falls short of the test of inventiveness.[27]

The principle of mechanical skill not amounting to invention was well-stated in *Hutchinson Mfg. Co.* v. *Mayrath*, 192 F. (2d) 110 (10 Cir., 1951), *cert. denied* 343 U.S. 914 (1952). That case is particularly applicable to the case at hand since all of the elements in each of the claims of the patent in question were disclosed in prior patents, although no single prior patent or disclosure showed all of the elements in a single device. After finding that each of the elements in the combination patent performed the same functions as they had in previous patents and that together they produced "no result other than the aggregate results of such functions," the Court held that the combination patent did not meet the *A & P* test whereby "the whole must exceed the sum of its parts." The Court then went on to say:

> "And where a patentee brings together old elements in a mechanism, involving no new principle, to produce an old result, although he produces a machine that is more efficient and hence more useful in the art, it is still the product of mechanical skill and not of invention."[28]

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[26] This was found to be a particular problem in the development of the Turner combine. See T.R. pp. 157-159 and 879-881.

[27] Altoona Publix Theatres, Inc. v. American Tri-Ergon Corp., 294 U.S. 477 (1935).

[28] Hutchinson Mfg. Co. v. Mayrath, 192 F. (2d) 110, 113 (10 Cir., 1951), cert. denied, 343 U.S. 914 (1952). This principle was also adopted by the United States Court of Appeals for the

INDEFINITENESS OF THE CLAIMS

In addition to the contention that patent number 2,974,467 is invalid in view of the prior art, the defendant argues that it is also invalid by reason of being vague, indefinite, and incomplete and does not, therefore, meet the standard set forth in 35 U.S.C., section 112. Title 35 U.S.C., section 112 states in part:

> "The specification shall contain a written description of the invention . . . in such full, clear, concise and exact terms as to enable any person skilled in the art . . . to make and use the same, and shall set forth the best mode contemplated by the inventor of carrying out his invention.
>
> "The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention."

The defendant contends that the terms "relatively large" when describing the first threshing cylinder and "relatively low" when describing the overall height of the com-

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Fourth Circuit in Ingersoll-Rand Co. v. Black & Decker Mfg. Co., 192 F. (2d) 270 (4 Cir., 1951), cert. denied, 343 U.S. 914 (1952). See also, B. F. Goodrich Co. v. United States Rubber Co., 147 F.Supp. 40 (D.Md., 1956), aff'd 244 F. (2d) 468 (4 Cir., 1957). It is interesting to note that, as the Supreme Court indicated in *A & P*, a combination of old elements in the fields of chemistry or electronics may well take on some new quality or function and result in patentability. See for example United States v. Adams, 383 U.S. 39 (1965), where a combination of old elements dealing with the interaction of metals and chemicals in a battery was held to be patentable, and Entron of Maryland, Inc. v. Jerrold Electronics Corp., 295 F. (2d) 670 (4 Cir., 1961), where a combination of old elements dealing with tap-off couplers for coaxial transmission lines used for supplying impulses to individual television sets was also held to be patentable. The Supreme Court went on to say in *A & P*, however, that such was not the "usual result" when combining old elements in the field of mechanics.

bine are not so exact as to enable one skilled in the art to make use of them. These terms are both mentioned in claim number one. Claims number two, three and four are all dependent upon claim number one, and therefore, if the terms are so indefinite as not to sufficiently describe the structure to one of ordinary skill in the art, all four claims must be invalidated.

The immediate question that arises as to the term "relatively" is, "relative to what?"[29] Stated otherwise, what is the basis of comparison which makes the first threshing cylinder "relatively large" and the overall height "relatively low?" An examination of the drawing included in the patent[30] reveals that the first threshing cylinder is indeed large as compared to either the transfer cylinder or the second threshing cylinder. It is also large as compared to the entire machine as its diameter appears to be about one-half of the height of the combine. Furthermore, it is large as compared to the threshing section as it appears to encompass about one-third of the volume. In addition to these possibilities,[31] which all deal with size, still another was suggested by the plaintiff's expert, Nolan, who said he thought "the term 'relatively large' meant threshing capacity as much as diameter size."[32] Nolan admitted on cross-examination, however, that there was no basis given in the patent for defining the term.[33]

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[29] B. F. Goodrich Co. v. United States Rubber Co., 147 F.Supp. 40, 75 (D.Md., 1956).

[30] Plaintiff's exhibit Nos. 1 and 2-A. The Court recognizes the principle that the claims should be read in light of the specifications and drawings. Reynolds v. Whitin Machine Works, 167 F. (2d) 78 (4 Cir., 1948). Even when this is done, however, confusion still exists as to what the term "relatively" means.

[31] T.R. pp. 957-960.

[32] T.R. p. 240.

[33] T.R. p. 283.

The claim that the combine is of a "relatively low" overall height is yet more elusive, for there is no basis of comparison one can derive by looking at this combine alone. As compared with other combines, Long's may be lower in height, but where as here no measurements are given, even this cannot be ascertained.

Courts have often looked with disfavor on terms such as "relatively," especially where, as here, it is used to describe what the plaintiff contends are key parts to the patent.[34] In applying the same theory to our case, it is important to remember that the plaintiff here relies heavily on the contention that the strucure of his combine is something new and therefore patentable. He also contends that two of the main features of this structure are the large threshing cylinder and the low overall height of the combine. No dimensions or bases for comparison can be found in the claims and description of the patent, however, and the various possibilities suggested by the term "relatively" only lead to confusion.

In holding claims one through four of patent number 2,974,467 invalid for indefiniteness, the Court finds this is wholly consistent with the purpose behind 35 U.S.C., section 112. Simply stated, that statute requires the clear definition of the claims of a patent so that one engaging in the same art will not run the risk of infringement during the tenure of the patentee's monopoly, to the end that, when the patent expires, the claims will teach one of ordinary skill in the art how to practice it.[35] As shown herein, the term "relatively" precludes this purpose from being fulfilled.

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[34] Todd v. Sears Roebuck & Co., 216 F. (2d) 594 (4 Cir., 1954); B. F. Goodrich Co. v. United States Rubber Co., 147 F.Supp. 40 (D.Md. 1956), aff'd, 244 F. (2d) 468 (4 Cir., 1957).

[35] Schiber-Schroth Co. v. Cleveland Trust Co., 305 U.S. 47 (1938); Wayne Knitting Mills v. Russell Hosiery Mills, Inc., 400 F. (2d) 964 (4 Cir., 1968), cert. denied, 393 U.S. 1064 (1969); Jones Knitting Corp. v. Morgan, 361 F. (2d) 451 (3 Cir., 1966).

Defective Oaths

The third defense that Lilliston raises as to patent number 2,974,467, is that the oaths, which Mr. Long made in connection with his patent application, were defective because material changes were made in the application after the oath was signed and before the application was filed. Specifically, the defendant contends that the flat plate, which connects the two arcuate perforated breastplates, was originally also perforated, but in the final patent which was granted it was imperforated. Additionally, the defendant contends that the first application did not contain figures 17 through 20, which do appear in the final patent. On these grounds, the defendant submits that patent number 2,974,467 is invalid for defective oaths and consequently patent number 3,007,475 is invalid for public use. For the reasons stated below, the Court finds these defenses without merit.

The evidence presented shows that Long filed two oaths in his application which resulted in patent number 2,974,467. The first oath was executed by Long on March 28, 1958, in Edgecombe County, North Carolina,[36] and the second oath was executed by Long on June 10, 1958, in Washington, D. C.[37] Accompanying the first oath were written and pictorial descriptions of the combine.[38] The written description clearly states that the plate was to be imperforated[39] and the illustration of the flat plate in the initial application is exactly the same as the illustration on the final patent.[40] Based on this, it is clear that

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[36] Defendant's exhibit No. 18, p. 25.

[37] Defendant's exhibit No. 18, p. 26.

[38] Defendant's exhibits Nos. 96 and 97.

[39] Defendant's exhibit No. 96, p. 7.

[40] Compare plaintiff's exhibit No. 1 (figure 59) with defendant's exhibit No. 97 (figure 59).

there was no change in the description of the flat plate and that it was to be imperforated. Mr. Long, however, testified on cross-examination that he thought the plate was to have holes in it.[41] In resolving this apparent conflict, we elect to adopt the writing and description of the application at the time it was made, rather than the testimony of Mr. Long as to what he thought some twelve years later. However, even if the testimony of Mr. Long were adopted and there was in fact a change in the characteristic of the flat plate, it would not be so significant or material as to render the oath and consequently both patents invalid. For the same reason, the Court discards the contention by the defendant that figures 17 through 20, which appear in the final patent, were not included in the original application, since they primarily show the attachment to the tractor and have no material bearing on the actual working of the combine.

Infringement

The final argument that Lilliston makes with regard to patent number 2,974,467 is that, even assuming the validity of the patent, there has been no infringement. To support this contention, Lilliston submits that there are material structural differences between its combine and Long's and, furthermore, the doctrine of file wrapper estoppel precludes Long from alleging infringement.

The main structural difference that the defendant points to in showing noninfringement is the "auger feeder."[42] This is a cylindrical structure which has spring fingers and which is located above and to the rear of the reel pickup. The defendant states that its primary function is to serve as a transfer system whereby the vines, which are picked up by the reel, are delivered to the three threshing cylinders, each successively higher and to the

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[41] T.R. p. 133.

[42] Plaintiff's exhibit No. 5, figure 2, item B. See also defendant's exhibit No. 149.

rear of the auger feeder. The alleged advantage of this system is that it is more efficient than other combines because, being wider at the point of pickup and narrower at the point where the vines are delivered from the auger feeder to the first threshing cylinder, more vines can be gathered into the machine on each run through the field.

The defendant strongly urges that the auger feeder was not intended to, nor does it in fact, act as part of the threshing cylinder means. The plaintiff, on the other hand, alleges that the auger feeder is in reality part of the threshing cylinder means and falls within claim number one of his patent.[43] The question to resolve, therefore, is whether, even assuming Long's patent is valid, the Lilliston combine is the same or substantially the same as Long's so as to conclude that there has been infringement under the doctrine of equivalents.

The leading case on the doctrine of equivalents is *Graver Tank and Manufacturing Company, Incorporated* v. *Linde Air Products Company,* 339 U.S. 605 (1950). There, the Supreme Court indicated that for infringement there does not have to be an exact copy of a patent. Rather, infringement can be declared where two machines are substantially the same with particular reference to the type of work, the method of operation, and the result. In establishing what constitutes equivalency the Court stated that "equivalency must be determined against the context of the patent, the prior art, and the particular circumstances of the case," and that "a finding of equivalence is a determination of fact."[44]

Applying the *Graver* test to the case at hand, the Court concludes that there is a substantial difference between the

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[43] It will be recalled that Long claimed a reel type pickup having spring fingers for engaging the vines and for conveying them into contact with the threshing cylinder means.

[44] Graver Tank and Manufacturing Company, Incorporated v. Linde Air Products Company, 339 U.S. 605, 609 (1950).

front ends of the two combines in question and therefore finds no infringement of patent number 2,974,467. The most striking evidence which leads to this conclusion is the difference between the concept claimed by Long, whereby the vines are fed directly from the reel pickup to the first threshing cylinder, and the idea that Lilliston uses in employing an auger feeder. Based on an examination of every other threshing cylinder in a cylinder type combine in the prior art, it cannot be said that Lilliston's auger feeder is a threshing cylinder. The reason for this is that under every other threshing cylinder (including those in the Lilliston and Long combines), there are spring fingers extending upward from the breastplates which, coacting with the spring fingers and rotation of the cylinders, perform the threshing function. No such spring fingers can be found under the auger feeder. It is significant to note at this point that even Mr. Long recognized this difference when, upon being asked to examine Lilliston's combine and point out the threshing cylinders, he did not mention the auger feeder. Rather, he noted that there were only three threshing cylinders because these were the only ones with spring fingers extending upwardly from the arcuate breastplates.[45] Of course, it is true, as the plaintiff contends, that some peanuts will fall off as the vines pass through the auger feeder.[46] It does not appear, however, that this is a significant amount. Furthermore, it is understandable that some peanuts will fall off the vines at this point when one considers the friction created as the vines pass through this narrow area.

As previously noted, if there is any novelty at all in Long's combine, it is in the concept whereby the vines picked up by the reel are conveyed directly to the first

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[45] T.R. pp. 39-40.

[46] This was testified to by defendant's witness William D. Kenney, T.R. p. 914.

threshing cylinder.[47] In fact, until Long came along, practically every other peanut combine employed a conveyor system or auger feeder of some type to carry the vines from the pickup to the first thresher.[48] A finding of significant difference in the auger feeder, therefore, takes Lilliston's combine away from any claim of infringement as to patent number 2,974,467, for clearly all other elements relating to this patent and which also may be found in Lilliston's combine are prevalent in the prior art and freely available to those who wish to use them.

In addition to finding Lilliston's auger feeder significantly and materially different from Long's as to structure, purpose, and result, the Court notes in passing that Lilliston has no "relatively large" threshing cylinder which Long has claimed as part of his invention. If anything, Lilliston's threshing units are rather small. Since this is only a matter of degree in size, however, the Court declines to find noninfringement solely on that basis.

File Wrapper Estoppel

Hand-in-hand with the doctrine of equivalents Lilliston submits that the court should also consider the doctrine of file wrapper estoppel to preclude Long from claiming infringement on the front end of the combine.[49] Under

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[47] In the file wrapper, Long emphasized this point when he said: "Applicant's combination of elements appears to be novel and patentable, being directed to the intimate association of the pickup and the threshing cylinder with the pickup located near the earth and supplying the peanut vines with the peanuts thereon directly to the threshing cylinder." Defendant's exhibit No. 18, p. 67. See also the testimony of defendant's expert Shefte, T.R. pp. 998-1002.

[48] This is readily shown in the Case and Livermon combines where a conveyor is used and in the Frick combine where a combination of a conveyor and feeding cylinder is employed.

[49] Exhibit Supply Company v. Ace Patents Corp., 315 U.S. 126 (1942).

the doctrine of file wrapper estoppel, a patentee who has altered or delimited his claims during the patent application process is bound by his limitations, and he cannot thereafter recapture what he has disclaimed against any equivalents.[50]

During the period of time when patent number 2,974,467 was being considered by the Patent Office, the examiner raised the question of how the pickup mechanism shown in figures 13-15 of the patent could be read in light of claim number 21 (now claim five), which is not part of this suit, but which does relate to claim number 17 (now claim one) which is in controversy here.[51] Figures 13-15 show a modification which can be attached to the front end of Long's combine in order to harvest peanuts when the vines are piled up rather than placed in windrows. In this mechanism, a shovel-type structure piles the vines onto a conveyor belt which, in turn, carries them toward a set of fingers rotating in a counterclockwise manner. The rotating fingers then convey the vines into contact with the first threshing cylinder.

In response to the examiner's inquiry, Long said that claim number seventeen (now claim one) is readable upon Figure 13.[52] In other words, Long concluded that the rotating fingers of this mechanism perform the pickup function and, therefore, could be read consistently with claim one.[53]

While the Court finds that the rotating fingers do aid in the delivery of the vines directly to the threshing cylin-

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[50] American Photocopy Equipment Co. v. Rovico, Inc., 257 F. Supp. 192 (N.D.Ill., 1966), aff'd, 384 F. (2d) 813 (7 Cir., 1967), cert denied, 390 U.S. 945 (1968), rehearing denied, 390 U.S. 1037 (1968).

[51] Defendant's exhibit No. 18, pp. 63-64.

[52] Defendant's exhibit No. 18, pp. 68-69.

[53] Apparently, the patent examiner was satisfied with this explanation and subsequently the patent was granted.

der in this mechanism, it cannot conclude that there is any picking up done by these fingers. Unlike the front end of the combine as used when harvesting the vines in windrows, these fingers rotate counterclockwise and at most convey the vines laterally rather than upwardly. Furthermore, it is clear that if anything acts as a pickup here it is the shovel which lifts the vines onto the conveyor. For these reasons, the Court finds claim number seventeen (now claim one) cannot be read on figures 13-15. Since noninfringement has been found by applying the doctrine of equivalents and without the use of file wrapper estoppel, however, the Court sees no need to pursue this point any further.

PATENT NUMBER 3,007,475

The back end or the cleaning, separating, and collecting portions of the combine are embodied in patent number 3,007,475. More specifically, this patent involves a stepped pan which receives peanuts falling through the openings in the second arcuate breastplate (under the read threshing cylinder). Peanuts are also received on this pan as they drop from the vines as the vines move downwardly along the vine rack on their way to being discharged through the exhaust. At the rearward end of the stepped pan is a declining stepped screen, which at its rearward end has a series of tines. The peanuts, which move toward the rear of the machine by an oscillating type motion, undergo their initial cleaning due to the jiggling effect on the peanuts as they are spread over and pass rearwardly on the surface of the pan. As the peanuts pass off the end of the stepped pan and onto the declining stepped screen, they enter a second cleaning phase whereby, due to air from the first blower passing through the steps and the jiggling motion of the combine causing the peanuts to bounce from one step to the next, clods of dirt and other foreign matter are separated from the peanuts. The stepped screen has holes in it through which an object

the size of a peanut will fall and move to the collecting point without passing over the tines at the end of the stepped screen or the stemmer saws underneath. Most of the peanuts, however, will be carried down the stepped screen, through the tines, and into the stemmer saws. These little saws will then, as they rotate and cut the vine stems, carry the peanuts to the collecting point. The collecting point herein referred to is a funnel-type structure whereby the peanuts will fall into a pipe. An air stream from a second blower will then move the peanuts up the inclined portion of the pipe and into a position where the air pressure is lowered and the peanuts can be discharged in collecting bags without injury to the collector.

The plaintiff alleges that all eight claims of this patent have been infringed. The claims are as follows:

> "1. In a peanut combine having means for elevating peanut vines with peanuts attached and for separating the peanuts from the vines, a housing, vine discharging means for discharging the vines from the rear of said housing, a stepped pan mounted in said housing and adapted to evenly spread the peanuts and move the same toward the rear of the machine, a stepped screen mounted in said housing below the discharge end of said pan for receiving peanuts from said pan, the openings in said screen being of a size to permit the peanuts to fall therethrough, a blower adapted to blow air through said screen to separate pieces of vine, dirt and trash from the peanuts, a connecting member located beneath said housing into which peanuts may fall by gravity, a peanut discharge pipe associated with said connecting member exteriorly of said housing and having a portion inclined upwardly and terminating in multiple discharge openings, a second blower on one end of said discharge pipe and adapted to blow the peanuts up said inclined portion and through said discharge openings, and an air vent

at the top of said inclined portion having means for reducing the air pressure so that the peanuts may be collected in bags without injury.

"2. In a peanut combine having means for elevating peanut vines with peanuts attached and for separating the peanuts from the vines, a housing, vine discharging means for discharging the vines from said housing, means adapted to receive the peanuts after they have been separated from the vines and to move the same in the machine, a screen for receiving the peanuts from the end of said peanut moving means, a blower adapted to blow air over said screen to clean said peanuts, a flared member lower than said screen whereby peanuts may fall by gravity from said screen into a discharge pipe in a minimum amount of space, a peanut discharge pipe operatively associated with said flared member having a portion inclined upwardly and terminating in a discharge opening, and means for moving the peanuts through said discharge pipe and through said discharge opening.

"3. The structure of claim 2 in which said last mentioned means comprises a second blower.

"4. The structure of claim 2 in which said screen has a plurality of tines to aid in cleaning said peanuts.

"5. In a peanut combine of low overall height and including means for separating the peanuts from the vines and for causing the peanuts and vines to pass through the machine, the improvement of an inclined screen onto which the peanuts are discharged, said screen having openings of a size through which the peanuts can fall, a blower having a discharge for directing air against said screen for separating foreign matter from the peanuts, a discharge pipe having one end open to receive peanuts from said screen, a conveyor tube connected to said discharge pipe and extending upwardly at an angle and with a depending

discharge extremity, said tube being provided with air venting means at its upper portion for the discharge of foreign matter and the release of air pressure whereby peanuts will be subjected to reduced air pressure upon their discharge.

"6. The structure of claim 5 in which said discharge extremity has multiple discharge openings, and valve means for selectively directing the discharge through said openings.

"7. In a peanut combine a downwardly inclined screen on which the peanuts are adapted to be received, said screen having openings of a size to allow the peanuts to fall therethrough, a blower for producing flow of air over said screen for removing foreign matter from the peanuts, a generally horizontally disposed discharge pipe located below said screen and extending laterally therefrom, a connection providing an inlet into one end portion of said discharge pipe through which peanuts falling through said screen are received, a conveyor tube connected to the other end portion of said discharge pipe, said conveyor tube extending upwardly at an angle and having a curved end portion terminating in a depending discharge extremity, and air venting means in the upper portion of said conveyor tube for the discharge of foreign matter and the release of air pressure whereby the peanuts will be subjected to reduced air pressure as they are discharged from the conveyor tube through said depending discharge extremity.

"8. In a peanut combine a downwardly inclined screen on which the peanuts are adapted to be received, said screen having openings of a size to allow the peanuts to fall therethrough, a blower for producing flow of air over said screen for removing foreign matter from the peanuts, a generally horizontally disposed discharge pipe located below said screen and extending

laterally therefrom, a connection providing an inlet into one end portion of said discharge pipe through which peanuts falling through said screen are received, a conveyor tube connected to the other end portion of said discharge pipe, said conveyor tube extending upwardly at an angle and having a curved end portion terminating in a depending discharge extremity, and air venting means in the upper portion of said conveyor tube for the discharge of foreign matter and the release of air pressure whereby the peanuts will be subjected to reduced air pressure as they are discharged from the conveyor tube through said depending discharge extremity, said discharge extremity having multiple discharge openings and valve means for selectively directing the discharge through said openings."

An analysis of these claims shows the significant features to be: (1) a housing; (2) a vine rack with a vine discharging means at the rear of the combine; (3) a stepped pan which spreads the peanuts and moves them toward the rear of the combine; (4) a declining stepped screen with openings large enough to allow peanuts to fall therethrough; (5) a blower used to blow air through the screen to aid in the movement of the peanuts down the steps and also help clean dirt from the peanuts; (6) a flared member where peanuts may fall by gravity after passing through the stepped screen or after passing through the stemmer saws which are located below the end of the stepped screen; (7) a discharge pipe inclined upwardly toward the front of the combine and terminating in multiple discharge openings; (8) a second blower which moves the peanuts up the inclined portion of the discharge pipe; and (9) an air vent to reduce pressure so that peanuts flowing through the discharge pipe can be gathered without harm to the individual working with the collecting bags. With particular reference to these features, the first question that must be answered is whether any of them individually, or all of them as a combination, are anticipated by the prior art so

as to render any or all of the claims of patent number 3,007,475 invalid in view of 35 U.S.C., section 103.

Prior Art

Under 35 U.S.C., section 103, and the *Graham* case, which sets forth the test to be applied thereto, it is clear that all of the significant features of patent number 3,007,475 appear time and again in the prior art, and that Long has simply combined old elements, otherwise not patentable by themselves, into a new machine. An in-depth comparison of the prior art, with what Long claims, will reveal the lack of novelty and nonobviousness and hence the lack of invention of any single element.

Peanut combines are almost always enclosed in a housing of some kind. Examples of this are the Frick, Krause, Livermon, Case, Ronning, Landrum,[54] and both Good patents. All of these combines also have vine racks which feed to a vine discharging means at the rear of the machine. A structure similar to Long's "stepped pan," although called by a different name, can be found in the Frick,[55] Livermon,[56] Morris,[57] Lilliston,[58] and both Good[59] combines, and a structure similar to Long's "stepped *screen*," although also called by a different name, can readily be seen in the Frick,[60] Case,[61] Landrum,[62] and

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[54] Defendant's exhibit No. 118.

[55] Defendant's exhibit No. 82, item No. W 18329 (peanut grid pan).

[56] Defendant's exhibits Nos. 52 and 88, item No. 62 (pan).

[57] Defendant's exhibit No. 59, items No. 81 and 82 (platform).

[58] Defendant's exhibit No. 56, item No. 44 (vibrating apron). This was in Lilliston's old carding type machine known as the "400" series.

[59] Defendant's exhibits Nos. 50 and 51, item No. 17 (grid pan).

[60] Defendant's exhibit No. 82, item No. W 19565 (cleaner grid pan).

[61] Defendant's exhibits Nos. 33 and 71.

[62] Defendant's exhibit No. 118, figure No. 4 (peanut chaffer).

Morris[63] combines. Practically every peanut combine known contains a blower which is used to aid in the cleaning process. In the Frick, Landrum, and Morris combines, this blower blows air through the screen structure to clean the peanuts of dirt and other foreign substances at that point. The flared member, or the focal point where the peanuts are collected after passing through the cleaning and separating processes, has its forerunner in the Frick,[64] Livermon,[65] and both Good[66] combines. Finally, the system employed by Long which includes a discharge pipe with a second blower and an air vent is almost an exact replica of the Boesch[67] patent and is apparently similar to the structure found in the Frick[68] combine.

From the foregoing survey of the prior art as compared with each element in the patent, it is clear that each feature of the patent was obvious to one skilled in the art and therefore would not be patentable by itself. It is equally clear, however, that if invention can be found in the combination of these old elements, then the patent is valid.[69] In order to show invention in patent number 3,007,475, the plaintiff contends that the declining of the stepped screen, the collecting point having a flared member, and the pneumatic conveyor system are new and significantly important ideas and the fact that these are

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[63] Defendant's exhibit No. 59, items Nos. 96 and 99 (grate).

[64] Defendant's exhibit No. 82, item No. W 19588 (peanut auger trough assembly).

[65] Defendant's exhibit No. 52, item No. 99 (chute).

[66] Defendant's exhibits Nos. 50 and 51, item No. 21 (peanut delivery auger or discharge conveyor trough).

[67] Defendant's exhibits Nos. 60, 60A, and 60B. See also the Everett conveyor, defendant's exhibit No. 35.

[68] T.R. pp. 122-123.

[69] Anderson's-Black Rock, Inc. v. Pavement Salvage Co., Inc., 396 U.S. 57 (1969); Webster Loom Co. v. Higgins, 105 U.S. 580 (1881).

all added into one combination with the other old elements warrants credit for an invention. Under the authority of *A & P* and other cases heretofore cited, we cannot agree with the plaintiff, but rather hold that the arrangement of parts here was only one of mechanical skill and cannot be marked with the stamp of invention.

In addition to the fact that every important feature of patent number 3,007,475 appears in the prior art, no new and different function or result can be found in any of these elements in Long's machine, either separately or as a combination. The housing and vine discharging means both serve the obvious purpose indicated by their names in all combines where they appear, which are many. The stepped pan, or similar structure, is also a standard part of a peanut combine and, as used by Long, is employed to aid in the spreading and movement of newly threshed peanuts to the cleaning portion and ultimately the collecting part of the combine. The stepped screen, or its equivalent, also serves the same purpose of aiding in the cleaning process in Long's machine as in the other combines which are part of the prior art. Another usual feature in peanut combines is a blower which, as in Long's combine, is used primarily to clean dirt from the peanuts as they move toward the stemmer saws. Finally, the conveyor system with the blower, inclined pipe, and air vent is exactly the same structure and serves the same purpose as the Boesch conveyor which is to provide a safe means for getting the peanuts from the trough, or wherever they are collected after passing through the cleaning processes, to the bags.

Of the three aforementioned elements which the plaintiff contends makes his machine different from the prior art, Long mainly relies on what he calls a "downwardly inclined stepped screen." Although it is true that the plaintiff has the first machine with a stepped screen inclined toward the rear, it has already been shown that this is not the first combine to contain a stepped screen; nor is

it the first combine where the screen works in connection with a blower in the cleaning process, which Long alleges is one of the advantages of his particular arrangement. Furthermore, this is not the first combine which has suggested a slanting screen. In fact, in some combines the stepped screen, although usually horizontal, was made so that it could be adjusted to a slanting position.[70] In others, the screen was made to be slanted but slanted toward the front rather than toward the rear.[71] In light of this evidence, we conclude that not only was this not a novel idea, but also that it was obvious to one of ordinary skill in the art. If anything, this arrangement only showed mechanical ability which, of course, will not suffice for invention.

The second feature which the plaintiff relies on to qualify the rear part of the combine for an invention is the flared member employed at the collecting point to guide the cleansed peanuts into the trough. This was nothing new, however, for a similar structure can be found in other combines, and it appears that the Frick combine uses practically the same configuration. Additionally, the nature of this structure is such that it would be obvious to use in this situation. Being similar to a funnel, it does what a funnel always does and its employment here, however skillful, was not inventive.

The third feature that Long relies on is his use of a pneumatic conveyor in this peanut combine. As the plaintiff himself indicated, however, the use of such a conveyor

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[70] Defendant's expert witness, Dalbert Shefte, testified that both the Case patent (defendant's exhibits Nos. 21 through 34), and the old Lilliston patent (defendant's exhibit No. 56), had screens which could be adjusted to vary the inclination. T.R. p. 1074.

[71] Shefte testified that this is shown in both the Eisenhart (defendant's exhibit No. 53) and Carroll (defendant's exhibit No. 125) patents. T.R. 1075. It also appears that the Frick combine shows this although the slant, if any, is very slight. Defendant's exhibit No. 82.

is not new to peanut combines and, in fact, is used in the Massey-Harris machine.[72] Furthermore, Long himself admitted that this was "like all pneumatic conveyors that I've seen used where you released the air and then released the material that you're blowing. There would be no other way to do it."[73] Assuming that the plaintiff, as an inventor, is at least one of ordinary skill in the art, it is clear that the use of the pneumatic conveyor here was obvious.

In concluding that patent number 3,007,475 is anticipated by the prior art and therefore invalid, it is noted that every significant feature of this patent appears not only in various combines throughout this history of the art, but also that they all appear in a single device in the prior art—the Frick combine, which, incidentally, was not before the patent examiner when Long's application was being processed. These points are particularly significant here in light of the factual situation that arose in *Graham*. There the Supreme Court examined the prior art and found that every essential element of the claimed patent was part of the prior art. In fact, the Court found that all of the items were included in the same patent (which was not before the patent examiner) except that two of the elements were reversed. Even so, however, the Court noted that their mechanical operation was identical and the same function was served. The patent was held invalid. In following the reasoning and result of *Graham* and holding that all eight claims of patent number 3,007,475 are invalid as anticipated by the prior art, it is also appropriate to conclude, as the Supreme Court did, that the patent in question "presents no operative mechanical distinctions, much less nonobvious differences."[74]

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[72] T.R. pp. 122-123.

[73] T.R. p. 141.

[74] Graham v. John Deere Co., 383 U.S. 1, 26 (1966). See also, Fn. 24, *infra*.

INDEFINITENESS OF THE CLAIMS

The second defense that Lilliston raises is that patent number 3,007,475 is invalid by reason of being vague, indefinite, and incomplete in light of 35 U.S.C., section 112. In making this contention, Lilliston primarily relies on the configuration and elements of the discharge system and argues that there is an inconsistency between claims one and two and claims five, seven and eight. Additionally, the defendant asserts that there is a discrepancy in the labeling of the stepped screen throughout the various claims. For the reasons stated below, the Court rejects these arguments and holds for the plaintiff on these points.

A comparison of the wording of claims one and two and claims five, seven and eight shows that while in claims one and two the discharge pipe is described as extending all the way from below the flared member up to the discharge opening, claims five, seven and eight describe the discharge pipe as extending only to the conveyor tube which, in turn, extends to the discharge opening. From the wording of the claims, therefore, it is not clear whether the pipe which extends upwardly and toward the front of the combine is supposed to be called the discharge pipe or the conveyor tube. The descriptions which accompany the claims, however, reveal that one and the same element is referred to here, and any confusion that would arise from the wording would be cleared up from a quick glance at the drawings.[75] Accordingly, we hold that one of ordinary skill could interpret the details of the discharge system and

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[75] Plaintiff's exhibit No. 2, figures 1, 2, 9 and 10. It is significant to note that this is a different result from the Court's holding with regard to the word "relatively" in patent number 2,974,467. There, even with the use of the drawings, it could not be clearly interpreted what "relatively" meant with regard to the large threshing cylinder or the overall height of the combine. Here, however, whatever may be confusing about the wording in the claims quickly becomes clear with the use of the accompanying drawings.

make use thereof. For the same reason the Court discards the contention of the defendant that in some claims the screen in question is referred to as an inclined screen, in others as a stepped screen, and in others simply as a screen. Suffice it to say that the drawing enclosed provides a clear view of the screen.[76] It is both inclined and stepped.

The defendant also contends that in claims five, seven and eight, an air vent is referred to as the means to reduce air pressure in the conveyor tube, but the means for creating this pressure—the second blower—is only mentioned in claims one and two. Lilliston submits, therefore, that these claims are invalid as incomplete. We do not agree, for not only do the words of the claims when taken together clearly indicate that this second blower is used to create the air pressure referred to, but also the drawings accompanying the patent disclose the blower, air vent, and conveyor, and the interrelation of these parts. One of ordinary skill in the art could make use of the discharge system as described. Both the substance and purpose of 35 U.S.C., section 112 have been met.

Best Mode Contemplated

In addition to the requirement that the specifications of a patent should be "in such full, clear, concise and exact terms as to enable any person skilled in the art" to make use thereof, 35 U.S.C., section 112, also dictates that the specifications "shall set forth the best mode contemplated by the inventor of carrying out his invention." Lilliston contends that Long has not complied with these requirements of the statute in that he has not shown either in his specifications, claims, or drawings, the baffle which is necessary to form a venturi at the point where the peanuts are introduced into the air stream which is created by the second blower. Lilliston also alleges that not only was this a necessary element to make the discharge system

[76] Plaintiff's exhibit No. 2, figure 1, item 95.

operative, but also that Long knew this was the best way to get the peanuts into the air stream and yet still failed to show it in his patent.[77]

While we find that the baffle was indeed necessary to make this discharge system operative, even though one is not shown in the patent, it is clear that one of ordinary skill in the art to which this system relates would be able to make use of this system by the minor modification of adding the baffle.[78] Furthermore, it is apparent that the omission of the baffle in Long's patent was inadvertent. There is no indication whatsoever that Long tried to deceive anyone or conceal anything from the public and without any evidence along this line, the Court does not presume any deception.[79]

Infringement

Even assuming patent number 3,007,475 is valid over the prior art, the defendant submits that its combine is significantly different from Long's in several respects and, therefore, there is no infringement. The main differences which Lilliston relies on are that it has employed an auger trough instead of a discharge pipe and it has no structure similar to Long's stepped screen. Under the doctrine of equivalents set forth in *Graver* and covered earlier in this opinion, the Court finds that, assuming the patent in question is valid, there has clearly been infringement. Every element in the back end of Lilliston's combine is substantially similar to corresponding elements in Long's combine in structure, function, and result. Since Long's patent is so clearly invalid as anticipated by the prior art, however, no further discussion on this point is necessary.

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[77] Compare defendant's exhibits Nos. 102.17 and 102.38 with plaintiff's exhibit No. 2, figure 10.

[78] Defendant's expert, Shefte, testified to this effect at T.R. p. 1052.

[79] Dashiell v. Grosvenor, 162 U.S. 425 (1896).

COMMERCIAL SUCCESS

In holding patent number 2,974,467 and patent number 3,007,475 invalid as anticipated by the prior art, we take cognizance of the fact that some of the combines considered here as part of the prior art had been discontinued around the time that Long received his patent.[80] We are also aware of the decision in *Reynolds* v. *Whitin Machine Works*, 167 F.(2d) 78 (4 Cir., 1948), *cert. denied*, 334 U.S. 844 (1948). In that case the defendant relied principally on one patent over one hundred years old and two others each over fifty years old to invalidate the plaintiff's patent by a showing of prior art anticipation. In upholding the validity of the patent, the United States Court of Appeals for the Fourth Circuit said, "Patents for useful inventions ought not be invalidated and held for naught because of such excursions into the boneyard of failures and abandoned experiments."

Although *Reynolds* would tend to support the plaintiff's contention that the lack of success of former patents indicates the validity of the plaintiff's patent, it is necessary to distinguish that case from the case at hand on the following grounds. First, it must be noted that the basis of the *Reynolds* decision was that there was a lack of novelty. As has been seen earlier, *Graham* v. *John Deere Co.*, supra, explicitly states that when 35 U.S.C., section 103, was enacted in 1952, the test of nonobviousness was added to the previously established tests of novelty and utility which must be met in upholding the validity of a patent. It is under the test of nonobviousness that the Court here invalidates the patents in question, and therefore the basis for decision in *Reynolds* cannot be applied here. Secondly, in our case most of the patents and combines of the prior art which are being dealt with were created within a decade

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[80] See testimony of plaintiff's witness J. M. Wagner, T.R. pp. 157-160, and defendant's witness William G. Moore, T.R. pp. 773-776, 783, 815.

of the time when Long's combine was patented. During this time new ideas were rapidly being developed and re-evaluated in the field of peanut combines. In the development of successive machines, and particularly in an area crowded with patents as the peanut combine field is, it is clear to the Court that as new ideas and devices are developed, older ones are phased out or may even prove utterly worthless. This may well be what happened here, and to allow the knowledge that the older patents imparted to then be patented would be to withdraw what is readily known and disclosed from the public domain contrary to the dictates of the constitution.[81]

We are also mindful of the fact that while many peanut combines previous to Long's were not commercially feasible, Long's machine has enjoyed substantial commercial success. The law is well-settled, however, that while commercial success may be a relevant factor in determining obviousness or nonobviousness,[82] without invention it will not make patentability.[83] This point was clearly enunciated in the recent case of *Anderson's-Black Rock, Inc.* v. *Pavement Salvage Co., Inc.*, 396 U.S. 57 (1969). That case dealt with the validity of a patent for a machine which combined four elements well known in the art of laying blacktop. In addition to a layer, spreader, and a screed, the patentee claimed that the inclusion of a radiant heat burner, whose object was to heat the edge of the preceding section of asphalt and thus enable the newly laid section to mold into the old slab with no resulting damage to the asphalt or corrosion in the "cold spot" area, constituted an invention.

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[81] Anderson's-Black Rock, Inc. v. Pavement Salvage Co., Inc., 396 U.S. 57 (1969); Graham v. John Deere Co., 383 U.S. 1 (1965).

[82] Graham v. John Deere Co., 383 U.S. 1 (1965); Entron of Maryland, Inc. v. Jerrold Electronics Corp., 295 F (2d) 670 (4 Cir., 1961); Reiner v. I. Leon Co., 285 F. (2d) 501 (2 Cir., 1960); Otto v. Koppers Co., Inc., 246 F. (2d) 789 (4 Cir., 1957).

[83] Anderson's-Black Rock, Inc. v. Pavement Salvage Co., Inc., 396 U.S. 57 (1969); Great Atlantic & Pacific Tea Co. v. Supermarket Equipment Co., 340 U.S. 147 (1950).

The Supreme Court first noted that radiant heat burners had been used in working with asphalt for over fifty years, and that its main function in this patent; i.e. softening the surface of the asphalt without burning it, was the same as it always had been. In answer to the question of whether the combination of these old elements created a valid patent, the Supreme Court said in a unanimous decision:

> "A combination of elements may result in an effect greater than the sum of the several effects taken separately. No such synergistic result is argued here. It is, however, fervently argued that the combination filled a long felt want and has enjoyed commercial success. But those matters 'without invention will not make patentability.' "[84]

Summary and Conclusions

Patents numbers 2,974,467 and 3,007,475 are invalid under 35 U.S.C., section 103, as anticipated by the prior art. In essence, both of these patents involve a combination of old parts or elements well known in the art. Although these combinations are recognized as forming a commercially profitable machine, no new function, operation or result can be found in either combination. Hence, even with the positive aspects of Long's machine taken into consideration, we must find that each patent only evidences mechanical skill, but is not inventive and therefore not patentable. In addition to the overwhelming evidence of prior art and the cases cited herein which interpret section 103, it is also noted that at least four patents were not taken into consideration by the Patent Office. One, the Frick combine, is particularly important since almost every element of Long's patent can be found in Frick. Another, the Boesch patent, contains a discharge system almost identical to Long's. We hold, therefore, that the defendant has met its burden and the patents are invalid.

---

[84] Anderson's-Black Rock, Inc. v. Pavement Salvage Co., Inc., 396 U.S. 57, 61 (1969).

With regard only to patent number 2,974,467 the Court also finds this patent invalid under 35 U.S.C., section 112, as being vague and indefinite. Even assuming the validity of that patent, however, the Court finds there has been no infringement by the defendant. As to patent number 3,007,475, assuming the validity of it, the Court finds this would be infringed by the defendant.

A final judgment order will be entered upon presentation, after endorsement by counsel.

WALTER E. HOFFMAN
United States District Judge

At Norfolk, Virginia
June 14, 1971

Order Correcting Memorandum

(Filed 7/16/71)

The following clerical or typographical errors are corrected on the opinion heretofore signed on June 14, 1971:

On page 19, footnote 30, 4th line thereof, the name "Whittin" should be changed to "Whitin." The same change should be made in the first line on page 50.

On page 21, footnote 35, last line thereof, reference to (2 Cir., 1966) should read (3 Cir., 1966).

On page 28, footnote 49, reference to Ace Products Corp. should read "Ace Patents Corp."

On page 43, fourth line from the bottom immediately preceding footnote 72, the words "Frick Machine" should read "Massey-Harris Machine."

On page 48, footnote 79, the letter "c" in Daschiell should be eliminated so that the spelling will read "Dashiell."

The Clerk is authorized to make these changes on the original memorandum.

Copies of this order are forwarded to counsel.

/s/ WALTER E. HOFFMAN
United States District Judge

At San Francisco, California
July 13, 1971

APPENDIX D

Judgment

(Filed 8/12/71)

THIS ACTION came on for trial before the Court, the Honorable Walter E. Hoffman, District Judge presiding by Special Assignment, and the issues having been duly heard and a Memorandum and Decision having been duly rendered and filed by the Court;

IT IS NOW, THEREFORE, ORDERED, ADJUDGED AND DECREED as follows:

The plaintiff shall take nothing of the defendant in this action and this action is hereby dismissed on the merits.

The patents in suit in this cause, United States Letters Patent Nos. 2,974,467 and 3,007,475, and each claim thereof are invalid and the same are declared void.

The defendant has not and is not now infringing United States Letters Patent No. 2,974,467.

Although the Court finds United States Letters Paten No. 3,007,475 to be so clearly invalid as anticipated by the prior art, had the Court determined said patent to be valid, then in that event the Court determines that the defendant would be infringing said patent under the doctrine of equivalents.

The defendant produced no evidence to support Count II of its Counterclaim. Therefore, Count II of the defendant's Counterclaim is dismissed with prejudice.

Attorneys' fees for the defendant, Lilliston Implement Company, are not allowed.

The defendant, Lilliston Implement Company, shall recover its costs.

Dated at Norfolk, Virginia, this ——— day of August, 1971.

WALTER E. HOFFMAN
United States District Judge

APPENDIX E

Constitutional Provisions, Statutes and Rules Involved

Constitution of the United States, Article I, Section 8 (1787):

Section 8. The Congress shall have Power . . .

. . .

To regulate Commerce with foreign Nations, and among the Several States, and with the Indian Tribes;

. . .

To promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries;

. . .

Act of June 25, 1948; c. 646; 62 Stat. 928; *Title 28, United States Code, Section 1254:*

Section 1254. Courts of appeals; certiorari; appeal; certified questions.

Cases in the courts of appeals may be reviewed by the Supreme Court by the following methods:

(1) By writ of certiorari granted upon the petition of any party to any civil or criminal case, before or after rendition of judgment or decree;

. . .

Patent Act of July 19, 1952; Public Law 593, 82nd Congress, 2d session; c. 950; 66 Stat. 792; Title 35, *United States Code, Section 103:*

Section 103. Conditions for patentability; non-obvious subject matter.

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the

subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Section 282. Presumption of validity; defenses

A patent shall be presumed valid. • • •

Rules of the Supreme Court of the United States

PART V. JURISDICTION ON WRIT OF CERTIORARI

19.

CONSIDERATIONS GOVERNING REVIEW ON CERTIORARI

• • •

1. (b) Where a court of appeals . . . has decided a federal question in a way in conflict with applicable decisions of this court; . . .

• • •

APPENDIX F

I. Disposition of Patent Cases by the Fourth Circuit Court of Appeals on the Question of Patentability or Infringement for the Five Years Just Prior to Graham v. John Deere Co., 383 US 1 (1966)

	Inv. or Sub. Op.	N.I. By P.C. N.O.	N.I. By Rev.	Val. & Inf.
Chicopee Mfg. Corp. v. *Kendall Co.*, 288 F2d 719 (1961)			x	
Honolulu Oil Corp. v. *Shelby Poultry Co.*, 293 F2d 127 (1961)				x
Entron of Maryland, Inc. v. *Jerrold Electronics Corp.*, 295 F2d 670 (1961)			x	
Power Curbers, Inc v. *E. D. Etnyre & Co.*, 298 F2d 484 (1962)				x
Triumph Hosiery Mills, Inc. v. *Alamance Industries*, 299 F2d 793 (1962)	x			
Universal Inc. v. *Kay Mfg. Corp.*, 301 F2d 140 (1962)				x
Keiser v. *High Point Hardware Co.*, 311 F2d 850 (1962)			x	
Nicholson v. *Carl W. Mullis Engineering & Mfg. Co.*, 315 F2d 532; c.d. 375 US 828 (1963)	x			
Berry Bros. Corp. v. *Sigmon*, 317 F2d 700 (1963)				x
Ransburg Electro-Coating Corp. v. *Proctor Electric Co.*, 317 F2d 302 (1963)				x
Heyl & Patterson, Inc. v. *McDowell Co., Inc.*, 317 F2d 719 (1963)			x	
Allen v. *Standard Crankshaft & Hydraulic Co., Inc.*, 323 F2d 29 (1963)	x			

	Inv. or Sub. Op.	By P.C. N.O.	N.I. By Rev.	Val. & Inf.
FMC Corp. v. *City of Greensboro*, 326 F2d 581 (1964)			x	
Technograph Printed Circuits, Ltd. v. *Bendix Corp.*, 327 F2d 497 (1964)		x		
Marvel Specialty Co., Inc. v. *Bell Hosiery Mills, Inc.*, 330 F2d 164 (1964)				x
Jackson v. *Dunham-Bush, Inc.*, 333 F2d 287 (1964)		x		
Servo Corp. of America v. *General Electric Co.*, 337 F2d 716 (1964)			x	
Pennco Engineering Co. v. *Allied Chemical Corp.*, 339 F2d 260 (1964)		x		
Cook Engineering & Electronics, Inc., v. *Hickory Co.*, 340 F2d 235 (1965)	x			
Collison Surgical Engineering Co. v. *Murray-Baumgartner Surgical Instrument Co., Inc.*, 343 F2d 162 (1965)		x		
Bullard Co. v. *General Electric Co.*, 348 F2d 985 (1965)	x			
Marston v. *J. C. Penney Co., Inc.*, 353 F2d 976 (1965)				x
	5	4	6	7

II. Disposition of Patent Cases by the Fourth Circuit Court of Appeals on the Question of Patentability or Infringement for the Period Between Graham (1966) and Anderson's-Black Rock, Inc. v. Salvage Co., 396 US 57 (1969)

	Inv. or Sub. Op.	N.I. By P.C. N.O.		Val. & By Rev. Inf.
Morpul, Inc. v. *Glen Raven Knitting Mill, Inc.*, 357 F.2d 732 (1966)	x			
Mabs, Inc. v. *Piedmont Shirt Co.*, 368 F2d 570 (1966)		x		
Tidewater Patent Development Co., Inc. v. *Kitchen*, 371 F2d 1004 (1967)			x	
Davis Harvester Co., Inc. v. *Long Mfg. Co.*, 373 F2d 513 (1967)		x		
Samuel J. Miller & Co. v. *A. Schreter & Sons Co.*, 374 F2d 510 (1967)		x		
Eversharp, Inc. v. *Philip Morris, Inc.*, 374 F2d 511 (1967)		x		
Gunter & Cooke, Inc. v. *Southern Electric Service Co.*, 378 F2d 60 (1967)		x		
Mahaffy & Harder Co. v. *Standard Packaging Corp.*, 389 F2d 525 (1968)	x			
Blaw-Knox Co. v. *Hartsville Oil Mill*, 394 F2d 877 (1968)			x	
Wilcox Mfg. Co. v. *Eastern Gas & Fuel Associates*, 400 F2d 960 (1968)	x			
Wayne Knitting Mills v. *Russell Hosiery Mills, Inc.*, 400 F2d 964 (1968)			x	
Grinnell Corp. v. *Virginia Electric & Power Co.*, 401 F2d 451 (1968)	x			
Porter-Cable Machine Co. v. *Black & Decker Mfg. Co.*, 402 F2d 517 (1968)				x
Pavement Salvage Co., v. *Anderson's-Black Rock, Inc.*, 404 F2d 450 (1968)				x
	4	5	3	2

III. Disposition of Patent Cases by the Fourth Circuit Court of Appeals on the Question of Patentability or Infringement for the Period Since Anderson's-Black Rock, Inc. Through and Including April 7, 1972

	Inv. or N.I. By Sub. Op.	By P.C. N.O.	By Rev.	Val. & Inf.
Blumcraft of Pittsburgh v. *Citizens National Bank*, 407 F2d 557 (1969)			x	
Cummins Engine Co., Inc. v. *General Motors Corp.*, 424 F2d 1368 (1970)		x		
Chemithon Corp. v. *Procter & Gamble Co.*, 427 F2d 893; c.d. 400 U.S. 925 (1970)		x		
Jenkins Metal Shops, Inc. v. *Pneumafil Corp.*, 427 F2d 144 (1970)		x		
Welch et al v. *General Motors Corp.*, 170 USPQ 1 (1970)		x		
Filterite Corporation v. *Tate Engineering, Inc.*, 447 F2d 62 (1971)		x		
General Dynamics Corp. v. *Whitcomb*, 443 F2d 630 (1971)			x	
Powell Mfg. Co., Inc. v. *Long Mfg. Co.*, 171 USPQ 328 (1971)		x		
Compton v. *Metal Products, Inc.*, 453 F2d 38 (1971)			x	
Long Mfg. Co. v. *Lilliston Implement Co.*, 173 USPQ 321 (1972)		x		
Calico Scallop Corp. et al v. *Willis Brothers, Inc. et al*, 173 USPQ 321 (1972)		x		
	0	8	3	0

Abbreviations:

Inv. —Invalid
N.I. —Not Infringed
Sub. Op.—Substantial Opinion
P.C. —Per Curiam
N.O. —No Substantial Opinion
Rev. —Reversal
Val. —Valid
Inf. —Infringed

COPY

IN THE

Supreme Court of the United States

OCTOBER TERM, 1972

No. 72-3

LONG MANUFACTURING COMPANY, *Petitioner*

v.

LILLISTON IMPLEMENT COMPANY, *Respondent*

BRIEF FOR RESPONDENT IN OPPOSITION TO PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FOURTH CIRCUIT

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The Long "475" Patent	7
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CASES CITED

Anderson's-Black Rock, Inc. v. *Pavement Salvage Co.*, 396 U.S. 57 (1969) 5, 16, 17, 18, 19, 20, 21

Graham v. *John Deere Co. of Kansas City*, 383 U.S. 1 (1966) 4, 5, 11, 12, 13, 14, 16, 17, 18, 19, 20, 21

Hotchkiss v. *Greenwood*, 11 How. 248 (1851) 16, 18

Great Atlantic & Pacific Tea Co. v. *Supermarket Equipment Corp.*, 340 U.S. 147 (1950) 4, 5, 11, 14, 15, 16 17, 18, 19, 20, 21

CONSTITUTIONAL PROVISION, STATUTES, AND RULE CITED

CONSTITUTION OF THE UNITED STATES:

Article I, Section 8, Clause 8 2

28 U.S.C. 1254(1) 2

35 U.S.C. 103 ..... 2, 11, 12, 17, 18

35 U.S.C. 282 3

RULE OF THE SUPREME COURT:

19(1)(b) 3

ABBREVIATIONS AND DESIGNATIONS

Pet. Petition for Writ of Certiorari.

Pet. A. Appendix to Petition.

p. page designation to Petition or Appendix to Petition.

Note: designation of pages of Appendix to Petition are followed by the suffix "a".

(IIIA ...) refers to Volume III of the Appendix in the Court of Appeals, each page of which is identified by number.

(PX ...) refers to Plaintiff's exhibits.

(DX ...) refers to Defendant's exhibits.

IN THE

Supreme Court of the United States

OCTOBER TERM, 1972

No. 72-3

LONG MANUFACTURING COMPANY, *Petitioner*

v.

LILLISTON IMPLEMENT COMPANY, *Respondent*

BRIEF FOR RESPONDENT IN OPPOSITION TO PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FOURTH CIRCUIT

I

OPINIONS BELOW

The opinion of the Court of Appeals for the Fourth Circuit, of which review is sought (now officially reported at 457 F.2d 1317 (1972)) is reprinted in the Appendix to the Petition (Pet. A. p. 1a).

The opinion of the District Court, E.D.N.C., officially reported at 328 F.Supp. 268 is reprinted in the Appendix to the Petition (Pet. A. p. 2a-40a).

II

JURISDICTION

The jurisdictional requisites for filing the Petition are adequately stated in the Petition, namely 28 U.S.C. 1254(1) reprinted in the Appendix to the Petition (Pet. A. p. 42a); however, there is no valid reason for review as provided by Supreme Court Rule 19(1)(b).

III

CONSTITUTIONAL PROVISION, STATUTES AND RULE INVOLVED

This case involves Article I, Section 8, Clause 8, of the Constitution, and Sections 103 and 282 of the Patent Code, 35 U.S.C. §§ 103 and 282.

Constitution

Article I, Section 8. The Congress shall have Power

* * *

8. To promote the Progress of Science and Useful Arts, by securing for limited Times to Authors and Inventors the exclusive right to their respective Writing and Discoveries;

Patent Code

35 U.S.C. 103. Conditions for patentability; non-obvious subject matter

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

35 U.S.C. 282. Presumption of validity; defenses

A patent shall be presumed valid. The burden of establishing invalidity of a patent shall rest on a party asserting it.

The following shall be defenses in any action involving the validity or infringement of a patent and shall be pleaded:

* * * *

(2) Invalidity of the patent or any claim in suit on any ground specified in part II of this title as a condition for patentability,

* * * *

Supreme Court Rules

Rule 19. Considerations governing review on certiorari

A review on writ of certiorari is not a matter of right, but of sound judicial discretion, and will be granted only where there are special and important reasons therefor. The following, while neither controlling nor fully measuring the court's discretion, indicate the character of reasons which will be considered:

* * * *

(b) Where a court of appeals has decided a federal question in a way in conflict with applicable decisions of this court;

* * * *

IV

QUESTIONS PRESENTED

1. Whether the Courts below have decided a Federal question in a way which conflicts with applicable decisions of this Court?

Note: Petitioner in setting out particulars to the above generic question asks:

"1.(a) Whether a novel combination of elements may properly be held unpatentable where the

> Court relies on *A. & P. Tea Co.* v. *Supermarket Corp.*, 340 U.S. 147 (1950) and does not apply *Graham* v. *John Deere Co.*, 383 U.S. 1 (1966)." (Pet. p. 2)

This is not in conformity with decisions below. The Court of Appeals found agreement with the decision of the District Court which *did not* find a *novel combination of elements* but only a new or different *arrangement of old elements* all of which were previously combined in prior art machines.

Moreover, *Graham* v. *John Deere Co.*, 383 U.S. 1 (1966) was applied and copious references made thereto.

Petitioner further asks:

> "1.(b) Whether, assuming the question of part (a) is answered affirmatively, the Court below erred in its application of *A & P* by its failure to make any finding as to whether Long's admittedly novel combination of elements 'perform any additional or different function in the combination than they perform out of it'. (340 U.S. 147 at 152)" (Pet. p. 2)

As pointed out with respect to 1.(a) above, the District Court *did not* find any *admittedly novel combination of elements.*

Furthermore, the District Court did make findings with respect to each patent in suit that the old elements which make up the device did not perform any additional or different function in combination than they performed out of it. Therefore, the District Court did not err in its application of *A & P.*

In view of the discrepancies in Petitioner's particulars 1.(a) and 1.(b), only the broad question appears proper.

2. Whether there is a conflict between this Court's rulings in *Anderson's-Black Rock, Inc.* v. *Pavement Salvage Co.*, 396 U.S. 57 (1969) (including *A & P*) and *Graham*?

V

COUNTER STATEMENT OF THE CASE

This is a case of alleged patent infringement. Two separate patents of the Petitioner are involved, namely, U.S. Patent No. 2,974,467 hereinafter referred to as "467" and U.S. Patent No. 3,007,475 hereinafter referred to as "475". The action was commenced in the United States District Court for the Eastern District of North Carolina on August 26, 1967. Jury trial was waived and the case came on regularly to be tried by the Honorable Walter E. Hoffman, Judge, by designation from the Eastern District of Virginia. The District Court filed a written memorandum opinion of its findings, conclusions and decision in June, 1971 (Pet. A. p. 2a-40a). Judgment was entered in August, 1971 adjudging both patents in suit and each claim thereof invalid; that Defendant has not and is not now infringing Patent No. "467"; and decreed that Plaintiff take nothing of the Defendant and that the action be dismissed on the merits. However, the Trial Court held that had it determined Patent No. "475" valid, then in that event the Defendant would be infringing said patent under the doctrine of equivalents. The Court denied the Defendant, as the prevailing party, attorneys' fees. (Pet. A. p. 41a)

The Plaintiff appealed and the Defendant cross-appealed from the portions of the judgment order that were adverse to each.

In a per curiam opinion decided April 4, 1972, after full consideration of the briefs and oral argument, the Court of Appeals for the Fourth Circuit agreed with the decision of the District Court that both of the patents in suit are invalid on the ground of obviousness to persons reasonably skilled in the art. In June, 1972, the Petition for Writ of Certiorari was filed.

The Long "467" Patent

Patent "467" relates to the front or pickup end of a peanut combine. As best shown in Figure 1 (IIIA 1) of this patent, the combine comprises front and rear threshing cylinders and an intermediate stripper cylinder which strips the vines from the front cylinder and passes them over the imperforate portion 59 of a breastplate 51 shown in Figure 8 (IIIA 4) to the rear cylinder. The vines are fed to the front threshing cylinder by the pickup 15-22 which includes spring fingers 19 which pick up the vines from the ground and deliver them directly to the front threshing cylinder. The threshing cylinders cooperate with curved sections of breastplate 51, which portions have perforations through which spring fingers project and cooperate with spring fingers on the threshing cylinders to detach the peanuts from the vines. The openings in the breastplate adjacent the rear cylinder are large enough to permit peanuts to fall through.

Claims 1-4 of the "467" patent (IIIA 10) were asserted.

Petitioner's argument basing validity on the simultaneously elevating and threshing theory raised on

appeal and again presented here has no merit in fact. None of the four claims of the "467" patent (IIIA 10) are directed to this so called or alluded to "dual function". Contrary to Petitioner's contention that the prior art did not have threshing cylinders arranged on an incline effective to elevate (Pet. p. 4), the District Court found:

> "Like the Long combine, the Livermon patent has a series of two cylinders whereby the rearward one is a little higher than the first. It should also be noted that the configuration of the two cylinders with a transfer cylinder between found in the Livermon patent, along with arcuate and perforated breastplates under each of the threshing cylinders and an imperforate plate which attaches the two arcuate perforated breastplates, is almost identical to the pattern used by Long.[24]" (Pet. A p. 10a-11a)

The Livermon patent, which was before the Examiner, was for a peanut picker. However, the same threshing cylinder arrangement was embodied in the Livermon combine DX 108 (IIIA 212-219) which was part of the pertinent art relied upon by the District Court that was not before the Examiner in the Patent Office.

The Long "475" Patent

Patent "475" (IIIA 11) is directed to the rear end of a combine where the peanuts are separated from the vines. This portion includes a stepped pan 85 which receives peanuts falling through the openings 67 in breastplate 51 under the rear threshing cylinder. As the vines leave that cylinder, they are received by a vine rack 74 which moves them to the rear of the combine where they are discharged by the members 80. The peanuts on pan 85 are fed rearwardly onto screen 95

which has perforations through which air from blower 98 is forced under pressure to blow away lightweight material from the peanuts. Peanuts discharged from screen 95 pass down an incline and through a grill 111, whence they pass into a flared member 112 and are then supposed to fall into discharge pipe 113 where air under pressure from a second blower 130 is said to move them across the combine in pipe 113 and up to the top of the combine in an inclined portion of that pipe, where the air pressure is lowered and the peanuts are released and collected for bagging.

All eight claims (IIIA 17) of the "475" patent were asserted. Petitioner relied on at Trial and on Appeal and relies here on what he calls a "downwardly inclined stepped screen". No claim of the "475" patent is directed to such a structure. The only claim that mentions a stepped screen is Claim 1 which is silent as to any inclination. The other claims variously recite a screen, an inclined screen, or a downwardly inclined screen; but are silent as to any stepped configuration.

Although, as discussed above, none of the claims of the "475" patent call for a "downwardly inclined stepped screen", the District Court adequately considered Petitioner's contention in this regard and found as follows:

> "Of the three aforementioned elements which the Plaintiff contends makes his machine different from the prior art, Long mainly relies on what he calls a 'downwardly inclined stepped screen.' Although it is true that the Plaintiff has the first machine with a stepped screen inclined toward the rear, *it has already been shown that this is not the first combine to contain a stepped screen; nor is it the first combine where the screen works in connection with a blower in the cleaning process, which*

Long alleges is one of the advantages of his particular arrangement. Furthermore, this is not the first combine which has suggested a slanting screen. In fact, in some combines the stepped screen, although usually horizontal, was made so that it could be adjusted to a slanting position. In others, the screen was made to be slanted but slanted toward the front rather than toward the rear. In light of this evidence, we conclude that not only was this not a novel idea, but also that it was obvious to one of ordinary skill in the art. If anything, this arrangement only showed mechanical ability which, of course, will not suffice for invention." (Emphasis added—Pet. A. p. 31a-32a)

Petitioner infers that the industry is dependent upon its combine; that it supplants prior combines; that it alone reduced the hazard of rain damage to the crop; and that the combines of the prior art were discontinued when Petitioner's alleged invention became known.

Such was not the finding of the courts below. Many of the prior art combines had come and gone before Petitioner entered the field and the finding of the Trial Court was as follows:

"*Around 1945, the idea developed that labor could further be reduced by producing a combine* which would move through the fields and harvest the peanut vines, which would previously be plowed up and placed in windrows rather than operating the machines in a stationary position. In addition to saving labor, another attractive feature about this method of harvesting is that the peanut vines could be harvested only a short period of time after having been dug up, since they would dry more quickly in the windrows than while piled up around stakes. *Accordingly, the hazard of rain damage to the exposed peanuts would be reduced.* Pursuant to these ideas and advantages, many ma-

chines were developed and patented, among which are the combines involved in this litigation.

"W. R. Long, the president of the *plaintiff company started working on the patented combine in 1956* and, by 1957, had built his first prototype." (Emphasis added—Pet. A. p. 5a)

* * * * *

"Secondly, in our case most of the patents and combines of the prior art which are being dealt with were created within a decade of the time when Long's combine was patented. During this time new ideas were rapidly being developed and re-evaluated in the field of peanut combines. In the development of successive machines and particularly in an area crowded with patents as the peanut combine field is, it is clear to the Court that as new ideas and devices are developed, older ones are phased out or may even prove utterly worthless. This may well be what happened here, and to allow the knowledge that the older patents imparted to then be patented would be to withdraw what is readily known and disclosed from the public domain contrary to the dictates of the constitution." (Pet. A. pp. 37a, 38a)

VI

ARGUMENT

The per curiam opinion of the United States Court of Appeals for the Fourth Circuit states that after full consideration of the briefs and oral argument, it is in agreement with the decision of the District Court that both of the Appellant's patents are invalid on the ground of obviousness to persons skilled in the art. It is submitted that the District Court's decision on the issue of validity was correct in every material respect.

The first reason alleged by the Petitioner for granting the writ requested is that the lower courts relied on

Great Atlantic and Pacific Tea Co. v. *Supermarket Equipment Corp.*, 340 U.S. 147 (1950) (hereinafter referred to as *A & P*) and did not apply *Graham* v. *John Deere Co. of Kansas City*, 383 U.S. 1 (1966) (hereinafter referred to as *Graham*).

This allegation is not correct since the District Court did rely on and apply the *Graham* decision. Thus, the District Court said:

> "The recent case of *Graham* v. *John Deere Co.*, 383 U.S. 1 (1966) established the test to be applied for cases arising under 35 U.S.C., section 103. In *Graham*, Mr. Justice Clark said:
>
> > 'Under § 103, the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved. Against this background, the obviousness or nonobviousness of the subject matter is determined.' [13]" (Pet. A. p. 9a)
>
> * * * * *
>
> "As has been seen earlier, *Graham* v. *John Deere Co.*, supra, explicitly states that when 35 U.S.C., section 103, was enacted in 1952, the test of nonobviousness was added to the previously established tests of novelty and utility which must be met in upholding the validity of a patent. It is under the test of nonobviousness that the Court here invalidates the patents in question, . . ." (Pet. A. p. 37a)

With respect to Patent No. 2,974,467, the District Court found:

> "Applying the *Graham* test to the case at hand, it is clear that all the working parts of the outstanding features of Patent Number 2,974,467 appear in previous patents and combines, which must

be considered part of the prior art.[14]" (Pet. A. p. 9a)

* * * * *

"This examination of the prior art as compared with each element of the patent in question compels the conclusion that each element was obvious to one of ordinary skill in the art, and therefore would not be patentable separately. Even so, a combination of these old elements could be patentable if invention can be found in the combination.[25]" (Pet. A. p. 11a)

* * * * *

"While the patentee should be commended for his success in arranging these old elements into a mechanically functional and most desirable combine, the new arrangement is only evidence of mechanical skill and falls short of the test of inventiveness.[27]" (Pet. A. p. 14a)

Thus, as to the Patent No. 2,974,467, the District Court recognized the *Graham* case as establishing a test to be applied and correctly applied that test by ascertaining the differences between the prior art and the claims at issue and resolving the level of ordinary skill in the pertinent art, resulting in a holding that mechanical skill only was involved.

Similarly, with respect to Patent No. 3,007,475, the District Court said:

"Under 35 U.S.C., section 103, and the *Graham* case, which sets forth the test to be applied thereto, it is clear that all of the significant features of patent number 3,007,475 appear time and again in the prior art, and that Long has simply combined old elements, otherwise not patentable by themselves, into a new machine. An in-depth comparison of the prior art, with what Long claims, will reveal the lack of novelty and nonobviousness and

hence the lack of invention of any single element." (Pet. A. p. 29a)

* * * * *

"From the foregoing survey of the prior art as compared with each element in the patent, it is clear that each feature of the patent was obvious to one skilled in the art and therefore would not be patentable by itself. It is equally clear, however, that if invention can be found in the combination of these old elements, then the patent is valid.[69]" (Pet. A. p. 30a)

* * * * *

"In concluding that patent number 3,007,475 is anticipated by the prior art and therefore invalid, it is noted that every significant feature of this patent appears not only in various combines throughout this history of the art, but also that they all appear in a single device in the prior art—the Frick combine, which, incidentally, was not before the patent examiner when Long's application was being processed. These points are particularly significant here in light of the factual situation that arose in *Graham*. There the Supreme Court examined the prior art and found that every essential element of the claimed patent was part of the prior art. In fact, the Court found that all of the items were included in the same patent (which was not before the patent examiner) except that two of the elements were reversed. Even so, however, the Court noted that their mechanical operation was identical and the same function was served. The patent was held invalid. In following the reasoning and result of *Graham* and holding that all eight claims of patent number 3,007,475 are invalid as anticipated by the prior art, it is also appropriate to conclude, as the Supreme Court did, that the patent in question 'presents no operative mechanical distinctions, much less nonobvious differences.'" (Pet. A. p. 33a)

The Petitioner also alleges that the District Court did not "give any weight to secondary considerations as set forth in *Graham*." These considerations are "commercial success, long felt but unsolved needs, failure of others, etc." and were clearly recognized by the District Court in its statements that:

> ". . . we take cognizance of the fact that some of the combines considered here as part of the prior art had been discontinued around the time that Long received his patent.[80]" (Pet. A. p. 37a)
>
> * * * *
>
> "We are also mindful of the fact that while many peanut combines previous to Long's were not commercially feasible, Long's machine has enjoyed substantial commercial success." (Pet. A. p. 38a)

These circumstances did not convince the Trial Court that the claimed subject matter was nonobvious.

In view of the foregoing, and of the entire content of the District Court's decision, it is submitted that the contention that the Trial Court did not apply the test of the *Graham* decision is untenable. Apparently, the results of such application were not what the Petitioner considers they should have been.

It is the findings of fact of the Trial Court that spells the invalidity of the patents in suit. The law as determined by the decisions of this Court applied to the facts as found by the Trial Court inevitably results in a judgment of invalidity. The Petitioner cannot demonstrate that there has been a misapplication of law to the facts as found. Given the findings of fact as determined by the Trial Court or conceding that they are not clearly erroneous as the Petitioner must do here renders the District Court's Judgment and Conclusion obviously sound.

The Petitioner's second alleged reason for granting the writ is that assuming the viability of *A & P*, the

District Court erred in its application of *A & P*. Here the Petitioner says:

> "Thus, in the case at bar there was no finding whether the elements perform any additional or different *function* in the combination than they perform out of it". (Emphasis quoted Pet. p. 11)

Petitioner's statement seems clearly incorrect. With respect to Patent No. 3,974,467, the District Court said:

> "In addition, the functions of the elements in Long's combine are the same as the functions they have performed in other combines." (Pet. A. p. 13a)

With respect to Patent No. 3,007,475, the District Court said:

> "In addition to the fact that every important feature of patent number 3,007,475 appears in the prior art, no new and different function or result can be found in any of these elements in Long's machine, either separately or as a combination." (Pet. A. p. 31a)

And then, with respect to both of the patents in suit, the District Court said:

> "In essence, both of these patents involve a combination of old parts or elements well known in the art. Although these combinations are recognized as forming a commercially profitable machine, no new function, operation or result can be found in either combination." (Pet. A. p. 39a.)

Clearly the Trial Court's findings answered the question of whether the elements of the claimed combination perform any additional or different function in the combination than they perform out of it. The findings were adverse to the Petitioner but such furnishes no basis for granting the petition to review the decision below.

The third reason alleged in the petition for granting the writ is that there is a "basic conflict" between the *A & P* case and *Anderson's-Black Rock* on one hand, and the *Graham* case on the other.

It is submitted that there is no conflict, basic or otherwise, between the three decisions in question. The *A & P* case was cited in each of the other two cases and that case, as well as the *Graham* case, was cited in the *Anderson's-Black Rock* case, and nowhere is there any intimation that any conflict was thought to exist. On the contrary the opinion in *Anderson's-Black Rock* discusses both of the other cases in detail and relies on both of them in reaching its conclusion.

The *A & P* case asserts the principle that a combination of old elements is not patentable unless the function of the whole combination in some way exceeds the sum of the functions of its parts. This principle of synergistic effect was reaffirmed in the *Anderson's-Black Rock* case. It is to be noted that this is not a universal test of patentability, but applies only to combinations of old elements.

This Court, in the *Graham* case, made it clear that the Congress by the Patent Act of 1952 *added* a third statutory dimension to the *two* requirements of novelty and utility that had been sole statutory tests since the Patent Act of 1793, namely the test of obviousness.

In considering what effect the 1952 Act had upon traditional statutory and judicial tests of patentability and what definitive tests are now required, this Court in *Graham* said:

> "We have concluded that the 1952 Act was intended to codify judicial precedents embracing the principle long ago announced by this Court in Hotchkiss v. Greenwood, 11 How. 248, 13 L.Ed. 683

(1851), and that, while the clear language of § 103 places emphasis on an inquiry into obviousness, the general level of innovation necessary to sustain patentability remains the same." *Graham* at 3 and 4.

This Court, further elucidating in *Graham* as to the basic factual inquiries to be considered under the § 103 condition, stated:

> "While the ultimate question of patent validity is one of law, Great A. & P. Tea Co. v. Supermarket Equipment Corp., supra, 340 U.S. at 155, 71 S.Ct. at 131, the § 103 condition, *which is but one of three conditions, each of which must be satisfied,* lends itself to several basic factual inquiries. Under § 103, the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved. Against this background, the obviousness or nonobviousness of the subject matter is determined. Such secondary considerations as commercial success, long felt but unsolved needs, failure of others, etc., might be utilized to give light to the circumstances surrounding the origin of the subject matter sought to be patented. As indicia of obviousness or nonobviousness, these inquiries may have relevancy." (Emphasis added) *Graham* at 17 and 18

The expression of this Court in *Graham* in no way indicates any conflict with *A & P* but sets forth guide lines to determine the obviousness or nonobviousness of the subject matter which is an added condition required by the Patent Act of 1952.

The *A & P* and *Anderson's-Black Rock* cases, on one hand, relate to the specific situation in which a combination of old elements is involved, and both cases, as

above noted, hold that in such a situation the total function must in some way exceed the sum of the individual functions. That holding was by no means new, but was based on a number of prior cases cited in the *A & P* opinion. It is not reasonable to suppose that this Court, by its pronouncements as to obviousness in the *Graham* decision, intended to overrule that established principle in general, and the *A & P* decision in particular; and the reaffirmance of the *A & P* principle in the *Anderson's-Black Rock* case, together with a citation and discussion of the *Graham* decision, makes it clear that there was no such intention and that this Court did not consider that there was any conflict between *A & P*, *Graham*, or *Anderson's-Black Rock*.

Moreover, any contention that this Court, in the *Graham* opinion, intended to impose any new standard of patentability is effectively negatived by the following express statement in that opinion:

> "We believe that this legislative history, as well as other sources[9] shows that the revision was not intended by Congress to change the general level of patentable invention. We conclude that the section [35 U.S.C. 103] was intended merely as a codification of judicial precedents embracing the Hotchkiss condition, with congressional directions that inquiries into the obviousness of the subject matter sought to be patented are a prerequisite to patentability." *Graham* at 17

The *A & P* and *Anderson's-Black Rock* cases simply state a rule to be applied in a specific case, namely that it will always be within the skill of the art to assemble old elements in combination if each element of the assembly merely performs its old function in the old way and the aggregate result is the sum of the functions of the elements. This is simply a rule of thumb for deter-

mining obviousness or nonobviousness in one of the many types of situations in which such a determination must be made. It is not at variance with anything contained in the *Graham* decision but is an aid in applying the principle of that decision to a specific kind of case; and it was so properly used by the District Court in the instant case.

To sum up, the *Graham* case holds that, in determining obviousness or nonobviousness, the scope and content of the prior art are to be determined, differences between such art and the claims are to be ascertained and the level of ordinary skill in the pertinent art is to be resolved, while the *A & P* and *Anderson's-Black Rock* cases hold that if, as the result of such a determination, it is found that the claims are drawn to a combination of elements, each of which is shown to be old in the prior art, then it would be obvious to combine those elements unless the combination produces a result different from the sum of the functions of the separate elements. This does not involve any conflict of decisions and does not present a situation in which the granting of certiorari would be appropriate.

The petitioner alleges that the *Anderson's-Black Rock* case has had the effect of causing the Court of Appeals for the Fourth Circuit to hold all patents coming before it invalid.

The number of cases involved appears to be too small to be significant, particularly since it is not shown how many of the cases decided involved combinations of old elements; but, so far as they might be considered as establishing any trends, they do not support the Petitioner's contentions. Thus, in the five year period preceding *Graham*, when the authority of the *A & P* was presumably unquestioned, the Fourth Circuit Court of

Appeals held seven out of twenty-two, or more than thirty percent of the patents considered, to be valid, while in the period between *Graham* and *Anderson's-Black Rock,* when the supposedly salutary effect of the *Graham* decision was in full force, only two out of fourteen, or less than fifteen percent of the patents considered were held valid. If this has any significance it could be that the *Graham* decision, rather than creating a more liberal standard, as the Petitioner seems to contend that it did, imposed a stricter one.

Assuming, as contended in the petition (Pet. p. 12) that *Graham* was "shoved aside" by *Anderson's-Black Rock,* thus reinstating *A & P* in full effect, then it is proper to consider those cases before *Graham* and after *Anderson's-Black Rock* as a unit; and when so considered, they show seven favorable holdings in thirty decisions, or twenty-three percent of favorable decisions, which is substantially more than the fifteen percent of Petitioner's supposedly golden age of the *Graham* decision.

It follows that the figures cited by Petitioner, if they have any material significance, tend to weaken the Petitioner's position rather than to strengthen it.

VII

CONCLUSION

Respondent submits that the opinion of the Trial Court shows a very able and scholarly application of the applicable law has been made to the controversy involved in this suit and that the Petitioner has received careful judicial consideration of all its contentions. Further that the approval of the Court of Appeals of the Trial Court's decision was entirely just and involves no error or misapplication of the law, nor is there any conflict between decisions of this Court

which were relied upon, nor any question of possible interest or importance which should absorb the time of this Court.

Furthermore, *Graham* was properly considered and the obviousness test properly applied by the District Court; *A & P* was properly considered and properly applied in a case involving a combination of old elements; and there is no conflict between *A & P* and *Anderson's-Black Rock* on one hand and *Graham* on the other.

It is submitted that the public interest has been served by the holding of the Court of Appeals for the Fourth Circuit that the patents in suit are invalid, and that the Petition is wholly without merit and should be denied.

Respectfully submitted,

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